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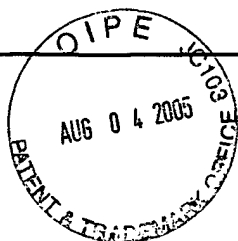
**COMBINED TRANSMITTAL OF APPEAL BRIEF TO THE BOARD OF PATENT  
APPEALS AND INTERFERENCES & PETITION FOR EXTENSION OF TIME  
UNDER 37 C.F.R. 1.136(a) (Small Entity)**

Docket No.  
99-004

In Re Application Of: **WALKER et al.**

Application No.	Filing Date	Examiner	Customer No.	Group Art Unit	Confirmation No.
09/360,422	July 23, 1999	James H. ZURITA	22927	3625	4171

Invention: **DETERMINATION AND PRESENTATION OF PACKAGE PRICING OFFERS IN RESPONSE TO  
CUSTOMER INTEREST IN A PRODUCT**



COMMISSIONER FOR PATENTS:

This is a combined Transmittal of Appeal Brief to the Board of Patent Appeals and Interferences and petition under the provisions of 37 CFR 1.136(a) to extend the period for filing an Appeal Brief.

Applicant(s) hereby request(s) an extension of time of (check desired time period):

☐ One month      ☐ Two months      ☐ Three months      ☒ Four months      ☐ Five months

from: April 3, 2005      until: August 3, 2005  
Date      Date

The fee for the Appeal Brief and Extension of Time has been calculated as shown below:

08/05/2005 MWOLDGE1 00000001 500271 09360422	Fee for Appeal Brief:	\$250.00
01 FC:2254 795.00 DA	Fee for Extension of Time:	\$795.00

**TOTAL FEE FOR APPEAL BRIEF AND EXTENSION OF TIME: \$1,045.00**

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- ☐ A check in the amount of \_\_\_\_\_ for the Appeal Brief and extension of time is enclosed.
- ☒ Please charge Deposit Account No. **50-0271** in the amount of **\$1,045.00**
- ☒ The Director is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. **50-0271**
- ☒ Any additional filing fees required under 37 C.F.R. 1.16.
- ☒ Any patent application processing fees under 37 CFR 1.17.
- ☒ If an additional extension of time is required, please consider this a petition therefor and charge any additional fees which may be required to Deposit Account No. **50-0271**
- ☐ Payment by credit card. Form PTO-2038 is attached.

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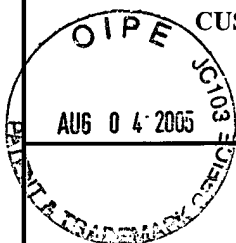
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Docket No.  
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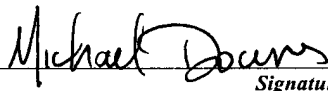
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Invention: **DETERMINATION AND PRESENTATION OF PACKAGE PRICING OFFERS IN RESPONSE TO  
CUSTOMER INTEREST IN A PRODUCT**



**TO THE COMMISSIONER FOR PATENTS:**

This combined Transmittal of Appeal Brief to the Board of Patent Appeals and Interferences and petition for extension of time under 37 CFR 1.136(a) is respectfully submitted by the undersigned:

  
Signature

Dated: **August 2, 2005**

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CC:

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Appellants: Jay S. Walker, Magdalena  
Mik and John B.  
Dickerson

) Group Art Unit: 3625

) Examiner: ZURITA, James H.

Application No.: 09/360,422

) **APPEAL BRIEF**

Filed: July 23, 1999

) Attorney Docket No.: 99-004

For: DETERMINATION AND  
PRESENTATION OF  
PACKAGE PRICING OFFERS  
IN RESPONSE TO  
CUSTOMER INTEREST IN A  
PRODUCT

**BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Appellants hereby appeal to the Board of Patent Appeals and Interferences  
from the decision of the Examiner in the Final Office Action mailed November 17,  
2004.

08/05/2005 MWOLDGE1 00000001 500271 09360422  
02 FC:2402 250.00 DA

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## **REAL PARTY IN INTEREST**

The present application is assigned to Walker Digital, LLC, 1177 High Ridge Road, Suite 128, Stamford, CT 06905.

## **RELATED APPEALS AND INTERFERENCES**

Appellants, Appellants' legal representative and Appellants' assignee know of no interferences or appeals that will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

## **STATUS OF CLAIMS**

Claims **1-72 and 74-126** are pending.

Claim 73 is canceled.

Claims **1-72 and 74-126** are rejected.

Only the following pending claims are being appealed:

Claims **3, 6, 7, 12, 13, 18, 19, 20, 23, 24, 29-35, 39, 40, 42, 44-46, 50, 53, 55, 56, 61, 66-68, 70-72, 75, 78, 79, 82, 85, 86, 88, 89, 93-96, 100-107, 113, 114, 116, 117, and 119-126.**



## **STATUS OF AMENDMENTS**

An amendment was mailed April 20, 2005, after the Notice of Appeal mailed February 1, 2005, and before any Appeal Brief. Appellants amended each of Claims **2, 9, 11, 13, 15, 17, 19, 22, 28, 30, 35, 48 and 123-124** to overcome the Examiner's objection to the claims. Appellants discussed the amendment with the Examiner by telephone on April 19. In an Advisory Action mailed May 10, 2005, Appellants received notice that the Amendment of April 20, 2005, was entered.

## SUMMARY OF CLAIMED SUBJECT MATTER

Claims 13, 19, 30, 35, 119, and 123-126 are independent.

Concise explanations of the independent claims are provided below. As required by 37 C.F.R. § 41.37(c)(1)(v), reference is made to the Specification. Any such reference and / or accompanying explanation:

(i) is by way of example of the claimed subject matter only and is not a comprehensive description of the scope of the independent claim being discussed, nor a comprehensive listing of support in the specification for the independent claim being discussed;

(ii) might be potentially useful in clarifying the particular subject matter of the particular independent claim being discussed (and not other claims or “the invention” as a whole), unless explicitly stated otherwise; and

(iii) is not to be considered as broadening or narrowing or otherwise affecting the interpretation of any claim or part of a claim, unless explicitly stated otherwise.

Additionally, any explanation or reference to the specification which refers to more than one claim, or is utilized in the explanation of more than one claim, is not to be considered as broadening or narrowing or otherwise affecting the interpretation of any claim or part of a claim, and is not to be considered as indicating any equivalence of any claims or parts of a claim.

### 1. **Independent Claim 13**

Claim 13 recites a computer-readable medium having stored thereon computer-executable instructions for performing a method for the determination and presentation of package offers in response to an indication of a customer's interest in a primary product. For some examples of detecting that a primary

product is of interest to a customer, see Specification, page 8, line 17 to page 9, line 4.

A package to be offered to the customer is determined, where the package includes at least the primary product of interest to the customer, and a secondary product that has not been selected for purchase by the customer, but in which the customer has indicated interest. The package is determined by accessing a database to select at least one secondary product to include in the package based upon at least one of the profit margin of the primary product and the profit margin of the secondary product. For some examples of determining a package, see Specification, page 9, lines 5-25.

A package price is determined in which the package price is less than the sum of the corresponding retail prices of the primary product and at least one secondary product. For some examples of determining a package price, see Specification, page 10, lines 1-12.

A package offer for sale at the package price is offered to the customer. For some examples of presentation of a package to a customer, see Specification, page 10, line 13 to page 12, line 18.

## **2. Independent Claim 19**

Claim 19 recites a computer-readable medium having stored thereon computer-executable instructions for performing a method for the determination and presentation of package offers in response to an indication of a customer's interest in a primary product. For some examples of detecting that a primary product is of interest to a customer, see Specification, page 8, line 17 to page 9, line 4.

A package to be offered to the customer is determined, where the package includes at least the primary product of interest to the customer, and a secondary

product that the customer has not been selected for purchase by the customer, but in which the customer has indicated interest. For some examples of determining a package, see Speciation, page 9, lines 5-25.

A package price is determined in which the package price is less than the sum of the corresponding retail prices of the primary product and at least one secondary product. A discounted price for each of the at least one secondary products is determined and the retail price of the primary product and the discounted price for the at least one secondary product are summed. For some examples of determining a package price, see Specification, page 10, lines 1-12.

A package offer for sale at the package price is offered to the customer. For some examples of presentation of a package to a customer, see Specification, page 10, line 13 to page 12, line 18.

### **3. Independent Claim 30**

Claim 30 recites a computer-readable medium having stored thereon computer-executable instructions for performing a method for the determination and presentation of package offers in response to an indication of a customer's interest in a primary product. For some examples of detecting that a primary product is of interest to a customer, see Specification, page 8, line 17 to page 9, line 4.

A package to be offered to the customer is determined, where the package includes at least the primary product of interest to the customer, and a secondary product that the customer has not been selected for purchase by the customer, but in which the customer has indicated interest. For some examples of determining a package, see Speciation, page 9, lines 5-25.

A package price is determined in which the package price is less than the sum of the corresponding retail prices of the primary product and at least one

secondary product. For some examples of determining a package price, see Specification, page 10, lines 1-12.

A package offer comprising the primary product and a predetermined number of secondary products chosen by the customer is presented to the customer. For some examples of presentation of a package to a customer, see Specification, page 10, lines 13-24.

#### **4. Independent Claim 35**

Claim 35 recites a computer-readable medium having stored thereon computer-executable instructions for performing a method for the determination and presentation of package offers in response to an indication of a customer's interest in a primary product. For some examples of detecting that a primary product is of interest to a customer, see Specification, page 8, line 17 to page 9, line 4.

A package to be offered to the customer is determined, where the package includes at least the primary product of interest to the customer, and a secondary product that the customer has not been selected for purchase by the customer, but in which the customer has indicated interest. For some examples of determining a package, see Specification, page 9, lines 5-25.

A package price is determined in which the package price is less than the sum of the corresponding retail prices of the primary product and at least one secondary product. For some examples of determining a package price, see Specification, page 10, lines 1-12.

A package offer comprising the primary product and a predetermined number of secondary products chosen by the customer from each of a plurality of lists is presented to the customer. For some examples of presentation of a package to a customer, see Specification, page 10, lines 19-24.

## **5. Independent Claims 119, 123, and 124**

Claim 119 recites a method for the determination and presentation of a package offer. Claim 123 recites an apparatus comprising a processor and a storage device that stores a program for directing the processor; the processor being operative with the program to perform the method of Claim 119. Claim 124 recites a computer-readable medium having stored thereon computer-executable instructions for performing the method of Claim 119. For some examples of detecting that a primary product is of interest to a customer, see Specification, page 8, line 17 to page 9, line 4.

A loss of interest in the primary product is detected. For some examples of detection of loss in the primary product, see Specification, page 40, lines 2-5.

In response to detecting a loss of interest in the primary product, a package to be offered to the customer is determined, the package comprising the primary product and at least one secondary product. For example of determining a package to offer to the customer in response to detecting a loss of interest in the primary product, see Specification, page 40, lines 1-14.

In response to determining the package, a package price is determined in which the package price is less than the sum of the corresponding retail prices of the primary product and at least one secondary product. For some examples of determining a package price, see Specification, page 10, lines 1-12.

A package offer for sale at the package price is presented to the customer. For some examples of presentation of a package to a customer, see Specification, page 10, line 13 to page 12, line 18.

**6. Independent Claim 125**

Claim 125 recites a method for the assembly, presentation and redemption of a package offer. For some examples of indicating that a primary product is of interest to a customer, see Specification, page 8, line 17 to page 9, line 4.

A loss of interest in the primary product is indicated. For some examples of indicating of loss in the primary product, see Specification, page 40, lines 2-5.

In response to indicating a loss of interest in the primary product, a package to be offered to the customer is determined, the package comprising the primary product and at least one secondary product. For example of determining a package to offer to the customer in response to detecting a loss of interest in the primary product, see Specification, page 40, lines 1-14.

A customer response comprising an account identifier and an indication of acceptance of the offer is provided, the acceptance of the package offer authorizing a charge to a financial account identified by the account identifier for the amount of the package price. For some examples of providing a customer response, see Specification, page 41, lines 16-25.

**7. Independent Claim 126**

Claim 126 recites a system for the assembly, presentation and redemption of package offers. The system comprises a processor, communications port in communication with the processor and a database in communication with the processor operable to store information relating to products. For some examples, see Specification, page 11, lines 5-16.

The processor is operable to interpret data received from a customer device as indicating expression of interest by a customer in a primary product. For some

examples of determining an expression of interest by a customer in a product, see Specification, page 8, line 17 to page 9, line 4.

The processor is further operable to interpret data received from a customer device as indicating a loss of interest by the customer in the primary product. For some examples of determining a loss of interest of a customer in a product, see Specification, page 40, lines 2-5.

The processor is further operable, in response to the data indicating a loss of interest, to access the database to determine a package to be offered to the customer, where the package includes at least the primary product and at least one secondary product. For some examples of determining a package, see Specification, page 9, lines 5-25 and page 40, lines 1-14.

The processor is further operable to determine a package price that is less than the sum of the corresponding retail prices of the primary product and at least one secondary product. For some examples of determining a package price, see Specification, page 10, lines 1-12.

The processor is further operable to present the package offer for sale at the package price to the customer. For some examples of presentation of a package offer to a customer, see Specification, page 10, line 13 to page 12, line 18.



## GROUND OF REJECTION TO BE REVIEWED ON APPEAL

### 1. Section 103(a)—Blinn + Peirce

Claims 3, 6, 7, 12, 13, 18-24, 29-35, 39, 40, 42, 44-46, 50, 53, 55, 56, 61, 66-68, 70-72, 75, 78, 79, 82, 85-89, 93-96, 100-107, 113, 114, 116, and 117 stand rejected under 35 U.S.C. § 103(a) as being obvious in view of:

U.S. Patent No. 5,897,622 issued to Blinn et al. (hereinafter “Blinn”),  
and

U.S. Patent No. 6,332,126 issued to Peirce et al. (hereinafter  
“Peirce”),  
and possibly in view of

Carol Tice, “Web Ordering May Alter Role of Distributors,” National Home Center News (June 22, 1998) (hereinafter “Tice”),  
and possibly in view of

assertions by the Examiner of subject matter not supported by  
evidence of record.

### 2. Section 103(a)—Blinn + Bernard

Claims 119-126 stand rejected as obvious under 35 U.S.C. § 103(a) in light  
of:

Blinn, and

U.S. Patent No. 5,918,213 issued to Bernard et al. (hereinafter “Bernard”).

## ARGUMENT

### 1. Summary of Arguments

All of the Section 103(a) rejections fail for two primary reasons: the Examiner has not made a prima facie case of obviousness, and in any event no reference(s) are of record that could support a showing of obviousness.

Second, even if any of the cited references disclosed the teachings asserted by the Examiner, the evidence of record lacks any teaching, suggestion, or motivation to combine the references in the manner suggested by the Examiner to produce the specific features of the claimed invention.

Third, even if the evidence of record supported the Examiner's purported motivation to combine the references in the manner suggested, the resulting combination would fail to teach or suggest the specific features of any claim.

Further, the Examiner has inappropriately relied on mere assertions of what was "obvious" or "well known" that are unsupported by any evidence of record.

Accordingly, the rejections are inappropriate and Appellants respectfully request that the rejections be reversed.

## 2. **Form of Appeal Brief**

In the arguments herein, limitations of the claims are indicated in *italics* and the references of record are indicated by underlining.

In separate arguments of patentability for separate claims (or groups of claims), Appellants have, where possible, referred to prior arguments to avoid undue repetition.

In the arguments below, Appellants refer to:

- Sixth Office Action: Final Office Action mailed October 17, 2004;
- Appellants' Fourth Response: Appellants' Response mailed April 1, 2004; and
- Fourth Office Action: Non-Final Office Action mailed October 22, 2003.

### **3. Subject Matter Without Support in the Record**

Subject matter without support in the record is not substantial evidence and accordingly cannot support a *prima facie* case of obviousness.

In the Fourth Office Action, the Examiner made various assertions as to what was well known in the art. In the Sixth Office Action, the Examiner provides a list of seven unsupported assertions as to “what the Examiner regards as knowledge that would have been generally available to one of ordinary skill in the art at the time the invention was made.” The Examiner argues the unsupported assertions (i) were not “adequately” traversed by Appellants and (ii) as a result are now “admitted prior art,” based on the Examiner’s reading of In re Boon. [Sixth Office Action, pages 6-7].

Appellants have several responses to this attempt by the Examiner to base a *prima facie* case of obviousness on unsupported assertions. The burden is not on Appellants to disprove any allegation unproven and unsupported by any evidence of record, so it is irrelevant whether such traverse is adequate or not. The burden is on the Examiner to build a *prima facie* case of obviousness on substantial evidence made of record. Also, Appellants submit that none of the Examiner’s unsupported assertions are “admitted prior art.” Further, the Examiner has misread and/or misapplied In re Boon.

#### **3.1. No evidence has ever been provided in support of assertions that the Examiner alleges were not “adequately traversed”**

Appellants note that the scope of the matter of which the Examiner (i) takes “official notice” or (ii) simply asserts is obvious, is limited to the substantial evidence in the record for such matter.

The references of record clearly do not support the Examiner's broad assertions as to what was "obvious" or "well known." The Examiner has not asserted otherwise.

Accordingly, the Examiner's assertions that are not supported by the references of record lack substantial evidence, and therefore cannot be used as prior art to the present application. Only the content of the references of record that are prior art to the present application may be so used. "[D]eficiencies of the cited references cannot be remedied by the Board's general conclusions about what is 'basic knowledge' or 'common sense.'" In re Zurko, 258 F.3d 1379, 1385 (Fed. Cir. 2001); In re Lee, 277 F.3d 1338, 1344 (Fed. Cir. 2002).

The burden is on the Examiner to establish a *prima facie* case based on substantial evidence. Where, as here, no evidence has been provided in support of what the Examiner insists is now "admitted prior art," no *prima facie* case has been established, and Appellants are under no obligation to rebut the Examiner's assertions with additional evidence or otherwise create "reasonable doubt" to overcome the rejections.

Any alleged failure of the Appellants to dispute what the Examiner has not proven could not suddenly transform any unsupported rejection into a *prima facie* case of obviousness. A *prima facie* case requires substantial evidence of record—the record still does not include any such evidence of the assertions the Examiner believes were not "adequately traversed."

Thus, there was and is no burden on Appellants to traverse assertions that no evidence of record could support, that the Examiner does not even allege are supported by the record, and which the Examiner has twice now been unwilling or unable to support with any evidence.

The rejections in the Sixth Office Action that improperly rely on “official notice” or what was purportedly “well known,” and / or on mere conclusory statements that certain features would be obvious, are discussed herein.

### **3.2. Appellants traverse the unsupported assertions**

Appellants hereby traverse the Examiner’s unsupported assertions listed on page 7 of the Sixth Office Action. Arguably, “reasonable doubt” as to the accuracy of the Examiner’s understanding of what the Examiner insists was “well known” and “knowledge generally available” is already created where the Examiner subsequently is unable or unwilling to point to any evidence of such knowledge in the prior art. Further, even if

### **3.3. No “admitted prior art”**

With respect to the Examiner’s determination that any unsupported yet asserted subject matter is not “admitted prior art” if Appellants were silent or did not “seasonably” traverse, In re Boon cannot support the Examiner’s analysis. First, as noted above, the Examiner’s reliance on the holding of In re Boon may be inappropriate in light of the later holdings of In re Zurko and In re Lee. Zurko and Lee clearly address the evidentiary burden placed on the Examiner, which the Examiner has failed to meet, regardless of Appellants’ response (or lack thereof) to assertions of the Examiner. Only the actual evidence of record matters, and the present record cannot support the Examiner’s assertions. Second, the Examiner has misinterpreted In re Boon. In re Boon has nothing to do with the burden on Applicants regarding unsupported assertions of what was “well known,” Official Notice, or factual findings during prosecution. In In re Boon, the court held that, in an appeal to the C.C.P.A., the Applicant needed to create a reasonable doubt regarding judicial notice by the Patent Office Board of Appeals. It was necessary

in that case for the applicants to create reasonable doubt before the C.C.P.A. because the applicants had not entered into the record a copy of the correspondence before the Board of Appeals following its decision in this case. Since there was no record of the appellants' prior arguments regarding the Board's judicial notice, the C.C.P.A. was unable to determine that the Board's judicial notice was improper.

In contrast to the facts controlling in In re Boon, the present application is still in prosecution, and further, Appellants' arguments are based on the lack of evidence of record supporting any *prima facie* case of obviousness. The evidence required to support the assertions by the Examiner in order to establish a *prima facie* case of obviousness is still lacking, whether Appellants specifically point out the lack of evidence or not. Further, Appellants still have the opportunity to point out any such failings of the record, and have done so at least in this Appeal Brief.

**4. Section 103(a)—Blinn + Peirce**

Appealed Claims **3, 6, 7, 12, 13, 18, 19, 20, 23, 24, 29-35, 39, 40, 42, 44-46, 50, 53, 55, 56, 61, 66-68, 70-72, 75, 78, 79, 82, 85, 86, 88, 89, 93-96, 100-107, 113, 114, 116, and 117** stand rejected under 35 U.S.C. § 103(a) as being obvious in view of:

Blinn and Peirce,

and possibly Tice,

and possibly assertions by the Examiner of subject matter not supported by evidence of record.

The Examiner's Section 103(a) rejections based on the above grounds are argued separately for the following Groups of appealed claims:

Group A.	Claims 3, 50, and 75
Group B.	Claims 6, 53, 78, and 113
Group C.	Claims 7, 68, 79, and 117
Group D.	Claims 12, 13, 61, and 82
Group E.	Claims 18, 19, and 85
Group F.	Claims 20 and 86
Group G.	Claims 23 and 88
Group H.	Claims 24 and 89
Group I.	Claims 29, 30, and 93
Group J.	Claims 31, 94, and 95
Group K.	Claims 32 and 33
Group L.	Claims 34, 35, and 96
Group M.	Claims 39, 100, and 116
Group N.	Claims 40, 66, and 101
Group O.	Claim 42



Group P.	Claims 44 and 105
Group Q.	Claims 45 and 106
Group R.	Claims 46 and 107
Group S.	Claim 56
Group T.	Claims 67, 102, and 104
Group U.	Claims 70 and 72
Group V.	Claim 71
Group W.	Claim 103
Group X.	Claim 114

The claims in different groups do not stand and fall together. Each of the Groups is addressed below under a separate heading.

#### **4.1. Applicable Law**

##### **4.1.1. Prima facie burden**

If examination at the initial stage does not produce a prima facie case of unpatentability, then without more the applicant is entitled to grant of the patent. In re Oetiker, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

During examination, claims are given their broadest reasonable interpretation consistent with the specification. In re Hyatt, 211 F.3d 1367 (Fed. Cir. 2000). The “PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant’s specification.” In re Morris, 127 F.3d 1048, 1054-55 (Fed. Cir. 1997).

##### **4.1.2. Substantial evidence required for all factual findings**

All findings of fact by the U.S. Patent and Trademark Office must be supported by substantial evidence within the record. In re Gartside, 203 F.3d 1305, 1315, 53 USPQ2d 1769, 1775 (Fed. Cir. 2000).

The Supreme Court has described "substantial evidence" in the following manner:

“substantial evidence is more than a mere scintilla. It means such relevant evidence as a reasonable mind might accept as adequate to support a conclusion. . . . Mere uncorroborated hearsay or rumor does not constitute substantial evidence.”

Consolidated Edison Co. v. NLRB, 305 U.S. 197, 229, 83 L. Ed. 126, 59 S. Ct. 206 (1938); See also, Dickinson v. Zurko, 527 U.S. 150, 162, 50 U.S.P.Q.2D 1930, 144 L. Ed. 2d 143, 119 S. Ct. 1816 (1999) ("Zurko III").

Similarly "review under this standard involves an examination of the record as a whole, taking into consideration evidence that both justifies and detracts from the agency's decision." Universal Camera Corp. v. NLRB, 340 U.S. 474, 487-88, 95 L. Ed. 456, 71 S. Ct. 456 (1951); Zurko III, 527 U.S. at 162. "[D]eficiencies of the cited references cannot be remedied by the Board's general conclusions about what is 'basic knowledge' or 'common sense.'" In re Zurko, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001); In re Lee, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

#### **4.1.3. Obviousness**

The Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art. In re Fritch, 972 F.2d 1260, 1265 (Fed. Cir. 1992). To reject claims in an application under section 103, an examiner must show an unrebutted *prima facie* case of obviousness. In re Rouffet, 149 F.3d 1350, 1355 (Fed. Cir. 1998). If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent. In re Oetiker, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

The factual predicates underlying an obviousness determination include the scope and content of the prior art, the differences between the prior art and the claimed invention, and the level of ordinary skill in the art. In re Rouffet, 149 F.3d 1350, 1355 (Fed. Cir. 1998). The secondary considerations are also essential components of the obviousness determination. In re Rouffet, 149 F.3d 1350, 1355 (Fed. Cir. 1998).

When a rejection is based on a combination of references, the Examiner can satisfy the prima facie burden only by showing some objective teaching leading to the purported combination of references. In re Fritch, 972 F.2d 1260, 1265 (Fed. Cir. 1992). Lacking a motivation to combine references, there is no prima facie case of obviousness. In re Rouffet, 149 F.3d 1350, 1358 (Fed. Cir. 1998).

The alleged motivation, whether based on prior knowledge or otherwise, must be supported by tangible teachings of reference materials. Cardiac Pacemakers, Inc. v St. Jude Medical, Inc., 381 F.3d 1371, 1376, 72 USPQ2d 1333, 1337 (Fed. Cir. 2004) ("Prior knowledge in the field of the invention must be supported by tangible teachings of reference materials "); Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1578-79, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997) ("However, **the record** must provide a teaching, suggestion, or reason to substitute computer-controlled valves for the system of hoses in the prior art. The absence of such a suggestion to combine is dispositive in an obviousness determination.") (emphasis added).

#### **4.2. Group A: Claims 3, 50, and 75**

Group A includes Claims **3, 50, and 75**.

Claims **3** depends from Claim **1**. Claim **50** depends from Claim **47**. Claim **75** depends from claim **74**.

Substantial evidence is required of all factual findings, as discussed above. Absent substantial evidence, no *prima facie* case of obviousness exists.

The rejection of Group A is flawed because the Examiner has not made a *prima facie* case of obviousness:

- the Examiner has consistently ignored the features generally directed to wherein *the indication that a primary product is of interest to a customer comprises detecting that information relating to the primary product is displayed on a web-page viewed by the customer for a pre-determined amount of time*;
- the Examiner has failed to provide substantial evidence that any such features were known at the time of invention; and
- the Examiner has failed to provide substantial evidence of a motivation to combine or modify the references to provide for such features.

##### **4.2.1. No substantial evidence of the limitations of Group A**

###### **Examiner's Factual Findings**

The Examiner has made no factual findings with respect to the additional limitations recited in Group A. In fact, the Examiner has not asserted that either Blinn, Peirce, or Tice even hints that an indication of interest in the primary product could comprise detecting or receiving an indication of the particular amount of time a customer views information about a primary product on a web-page, much less that the amount of time is a predetermined amount of time.

### No Substantial Evidence of the Limitations

Appellants have repeatedly read Blinn, Peirce, and Tice and have found no hint of any of the additional limitations of Group A. The Examiner does not specifically address any such limitations.

Since “detecting that the primary product is of interest to the customer” causes a package to be presented to the customer, in the embodiments of claims **3, 50 and 75** “detecting that information relating to the primary product is displayed on a web-page viewed by the customer *for a predetermined amount of time*” causes a package including the primary product and at least one secondary product to be presented to the customer. Thus, for example, if a customer views a web page that displays information on a product for at least one minute, it may be inferred that the customer is interested in the product but still undecided about purchasing it. That may be an opportune time to present the customer with an offer for a package that includes the product and one or more additional products, as an incentive to the customer to purchase the product.

The method of Blinn does not allow a retailer to take advantage of such an opportunity. Blinn merely describes that when a customer selects a product for purchase, a cross-sell product may be offered to the customer. Blinn does not describe determining an amount of time that information relating to a product is displayed on a web-page viewed by the customer, much less presenting a package to the customer if the amount of time is a pre-determined amount of time.

To the extent that the Examiner is relying solely upon Blinn, Peirce, or Tice as teaching the additional features recited in Group A, the Section 103(a) rejection cannot stand. The Examiner has failed to indicate any evidence of such features, much less substantial evidence.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness. Neither Blinn, Peirce, nor Tice, alone or in combination, can support any such rejection. The rejection of Group A fails for at least this reason.

**4.2.2. No substantial evidence of a proper motivation to combine or modify the references**

The Examiner has failed to address any additional limitation of Group A or assert that either Blinn, Peirce, or Tice even hint at any additional limitation of Group A. Further, the Examiner simply has not even asserted any motivation to modify or combine the references to provide for the specific recited features of Group A, much less a motivation supported by the cited references or by substantial evidence of record.

The only motivation indicated by the Examiner for combining Blinn and Peirce is:

One of ordinary skill in the art at the time the invention was made would have been motivated to combine Blinn and Peirce to disclose that at least one of the secondary product is selected for including in a package based on indications by a customer in the at least one secondary product for the obvious reason that a proven method of effective and efficient marketing is to identify customers that are more likely to be interested in a merchant's product by identifying customers and products based on similar or related purchases in the past.

[Sixth Office Action, page 11].

The Examiner also states:

Blinn discloses merchandising, "Electronic shopping and merchandising system." Merchandising is sales promotion as a comprehensive function including market research development of new products, coordination of manufacture and marketing and effective advertising and selling.

[Sixth Office Action, pages 10-11 (emphasis added) (footnote citing Merriam Webster's Collegiate Dictionary omitted)].

The Examiner's explanation (referred to herein as the "Examiner's Blinn-Peirce Motivation") clearly fails to establish a *prima facie* case of obviousness, for several reasons.

First, the mere use of the word "merchandising" in the title of Blinn does not suggest any and all features that would provide for "effective advertising and selling," much less a specific feature wherein *the indication that a primary product is of interest to a customer comprises detecting that information relating to the primary product is displayed on a web-page viewed by the customer for a pre-determined amount of time.*

Second, the Examiner the asserted motivation "to identify customers...by identifying customers and products based on similar or related purchases in the past" does suggest the desirability of providing specifically for a feature wherein *the indication that a primary product is of interest to a customer comprises detecting that information relating to the primary product is displayed on a web-page viewed by the customer for a pre-determined amount of time.* There is nothing in the asserted motivation that suggests a request for a package associated with any product, much less associated with the primary product.

For example, even if the prior art did teach one of ordinary skill in the art that "identify[ing] customers that are more likely to be interested in a merchant's product by identifying customer and products based on similar or related purchases in the past," that would not mean that *all manners* of marketing based on past purchases would be obvious. Yet, that is exactly what the Examiner asserts: that it would have been obvious "to identify customers and products based on similar or related purchases in the past."

"Recognition of a need does not render obvious the achievement that meets that need. There is an important distinction between the general motivation to cure an uncured disease (for example, the disease of multiple forms of heart



irregularity), and the motivation to create a particular cure." Cardiac Pacemakers, Inc. v St. Jude Medical, Inc., 381 F.3d 1371, 72 USPQ2d 1333, 1337 (Fed. Cir. 2004).

Thus, the Examiner has not shown that the references would prompt one of ordinary skill in the art to combine the references in the manner suggested by the Examiner to provide specifically for wherein *the indication that a primary product is of interest to a customer comprises detecting that information relating to the primary product is displayed on a web-page viewed by the customer for a pre-determined amount of time.*

Finally, the Examiner has not indicated any reasoning why one of ordinary skill in the art would have looked to Blinn based on the teachings of Peirce, or vice versa. The vague assertion that it is a "proven method" to identify "customers and products based on similar or related purchases in the past" clearly is not substantial evidence of a suggestion in the prior art of a motivation to provide for the proposed combination.

Thus the Examiner has not shown substantial evidence of a motivation in the prior art of record to combine or modify the references in any manner that renders the claims of Group A obvious. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness. The rejection of Group A fails for at least this reason.

#### **4.2.3. Conclusion**

For any one of the above reasons, the Examiner has failed to establish a *prima facie* case of obviousness and the claims of Group A are patentable.

#### **4.3. Group B: Claims 6, 53, 78, and 113**

Group B includes Claims **6, 53, 78, and 113**.

Claims **6** depends from Claim **1**. Claim **53** depends from Claim **47**. Claim **78** depends from claim **74**. Claim **113** depends from Claim **108**.

Substantial evidence is required of all factual findings, as discussed above. Absent substantial evidence, no *prima facie* case of obviousness exists.

The rejection of Group B is flawed because the Examiner has not made a *prima facie* case of obviousness:

- the Examiner has consistently ignored the features generally directed to *at least one keyword input into an input field on a web-page* and wherein *the at least one keyword relates to the primary product*;
- the Examiner has failed to provide substantial evidence that any such features were known at the time of invention; and
- the Examiner has failed to provide substantial evidence of a motivation to combine or modify the references to provide for such features.

##### **4.3.1. No substantial evidence of the limitations of Group B**

###### Examiner's Factual Findings

The Examiner has made no factual findings with respect to the additional limitations recited in any of Group B. In fact, the Examiner has not asserted that either Blinn, Peirce, or Tice even hints at any specific limitation of Group B.

###### No Substantial Evidence of the Limitations

Appellants have repeatedly read Blinn, Peirce, and Tice, and have found no hint of any of the additional limitations of Group B. The Examiner does not specifically address any such limitations.

To the extent that the Examiner is relying solely upon Blinn, Peirce, or Tice as teaching any feature recited in Group B, the Section 103(a) rejection cannot stand. The Examiner has failed to indicate any evidence of such features, much less substantial evidence.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness. Neither Blinn, Peirce, nor Tice, alone or in combination, can support any such rejection. The rejection of Group B fails for at least this reason.

**4.3.2. No substantial evidence of a proper motivation to combine or modify the references**

The Examiner has failed to address any additional limitation of Group B or assert that either Blinn, Peirce, or Tice even hint at any additional limitation of Group B. Further, the Examiner simply has not even asserted any motivation to modify or combine the references to provide for the specific recited features of Group B, much less a motivation supported by the cited references or by substantial evidence of record.

The Examiner's Blinn-Peirce Motivation of pages 10-11 of the Sixth Office Action (discussed and traversed above) does not suggest specifically the desirability of providing for features generally directed to *at least one keyword input into an input field on a web-page* and wherein *the at least one keyword relates to the primary product*. The Examiner does not assert otherwise.

Thus the Examiner has not shown substantial evidence of a motivation in the prior art of record to combine or modify the references in any manner that renders the claims of Group B obvious. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness. The rejection of Group B fails for at least this reason.

#### **4.3.3. Conclusion**

For any one of the above reasons, the Examiner has failed to establish a *prima facie* case of obviousness and the claims of Group B are patentable.

#### **4.4. Group C: Claims 7, 68, 79, and 117**

Group C includes claims 7, 68, 79 and 117.

Claim 7 depends from Claim 1. Claim 68 depends from Claim 47. Claim 79 depends from claim 74. Claim 117 depends from Claim 108.

Substantial evidence is required of all factual findings, as discussed above. Absent substantial evidence, no *prima facie* case of obviousness exists.

The rejection of GROUP C is flawed because the Examiner has not made a *prima facie* case of obviousness:

- The Examiner has consistently ignored claim features generally directed to wherein *an interest in a primary product comprises a request for a package associated with the primary product*;
- The Examiner has failed to provide substantial evidence that any such feature was known at the time of invention; and
- The Examiner has failed to provide substantial evidence of a motivation to combine or modify the references to provide for such a feature.

##### **4.4.1. No substantial evidence of a proper motivation to combine or modify the references**

The only motivation indicated by the Examiner for combining Blinn and Peirce is:

One of ordinary skill in the art at the time the invention was made would have been motivated to combine Blinn and Peirce to disclose that at least one of the secondary product is selected for including in a package based on indications by a customer in the at least one secondary product for the obvious reason that a proven method of effective and efficient marketing is to identify customers that are more likely to be interested in a merchant's product by identifying customers and products based on similar or related purchases in the past.

[Sixth Office Action, page 11].

The Examiner also states:

Blinn discloses merchandising, “Electronic shopping and merchandising system.” Merchandising is sales promotion as a comprehensive function including market research development of new products, coordination of manufacture and marketing and effective advertising and selling.

[Sixth Office Action, pages 10-11 (emphasis added) (footnote citing Merriam Webster’s Collegiate Dictionary omitted)].

The Examiner’s explanation clearly fails to establish a *prima facie* case of obviousness, for several reasons.

First, the mere use of the word “merchandising” in the title of Blinn does not suggest any and all features that would provide for “effective advertising and selling,” much less a specific feature wherein *an interest in a primary product comprises a request for a package associated with the primary product*.

Second, the Examiner the asserted motivation “to identify customers...by identifying customers and products based on similar or related purchases in the past” does suggest the desirability of providing specifically for a feature wherein *an interest in a primary product comprises a request for a package associated with the primary product*. There is nothing in the asserted motivation that suggests a request for a package associated with any product, much less associated with the primary product.

For example, even if the prior art did teach one of ordinary skill in the art that “identify[ing] customers that are more likely to be interested in a merchant’s product by identifying customer and products based on similar or related purchases in the past,” that would not mean that *all manners* of marketing based on past purchases would be obvious. Yet, that is exactly what the Examiner asserts: that it

would have been obvious "to identify customers and products based on similar or related purchases in the past."

"Recognition of a need does not render obvious the achievement that meets that need. There is an important distinction between the general motivation to cure an uncured disease (for example, the disease of multiple forms of heart irregularity), and the motivation to create a particular cure." Cardiac Pacemakers, Inc. v St. Jude Medical, Inc., 381 F.3d 1371, 72 USPQ2d 1333, 1337 (Fed. Cir. 2004).

Thus, the Examiner has not shown that the references would prompt one of ordinary skill in the art to combine the references in the manner suggested by the Examiner to provide specifically for wherein *an interest in a primary product comprises a request for a package associated with the primary product*.

Finally, the Examiner has not indicated any reasoning why one of ordinary skill in the art would have looked to Blinn based on the teachings of Peirce, or vice versa. The vague assertion that it is a "proven method" to identify "customers and products based on similar or related purchases in the past" clearly is not substantial evidence of a suggestion in the prior art of a motivation to provide for the proposed combination.

Thus the Examiner has not shown substantial evidence of a motivation in the prior art of record to combine or modify the references in any manner that renders the claims of Group C obvious. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness. The rejection of Group C fails for at least this reason.

#### **4.4.2. No substantial evidence of the limitations of Group C**

Even if the Examiner had established substantial evidence of a motivation to make the proposed combination of Blinn and Peirce (which Appellants dispute

above), the Examiner has failed to provide substantial evidence of a motivation to modify that combination that would provide for wherein *an interest in a primary product comprises a request for a package associated with the primary product*.

In fact, even if the references were combined in the manner suggested (let alone any other manner that the Examiner failed to suggest), the proposed combination would fail to such a feature. Appellants have repeatedly read Blinn, Peirce, and Tice and have found no hint of any of the additional limitations of Group C. The Examiner does not specifically address any such limitations.

As stated in Appellants' Fourth Response, pages 27-28 (emphasis added):

Blinn does not describe or suggest such a feature. In Blinn, the program module follows the same steps with every order: it checks whether an item selected for purchase has an associated cross-sell item in a database and, if so, presents the cross-sell item to the customer. See, for example, 21, line 62 through column 22, line 45. **A customer has no control or input as to whether a cross-sell item will be presented in Blinn.**

As Appellants understand the record, the Examiner did not acknowledge or respond to this argument in the Sixth Office Action.

Nothing in Peirce or Tice even hints at a customer requesting a package that is associated with a primary product, much less that such a request specifically could constitute an indication of interest in a primary product. The Examiner does not assert otherwise.

To the extent that the Examiner is relying solely upon Blinn, Peirce, or Tice as teaching the additional features recited in Group C, the Section 103(a) rejection cannot stand. The Examiner has failed to indicate any evidence of such features, much less substantial evidence.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness. Neither Blinn, Peirce, nor Tice, alone or in combination, can support any such rejection. The rejection of Group C fails for at least this reason.



#### **4.4.3. Conclusion**

For any one of the above reasons, the Examiner has failed to establish a *prima facie* case of obviousness and the claims of Group C are patentable.

#### **4.5. Group D: Claims 12, 13, 61, and 82**

Group D includes Claims 12, 13, 61, and 82.

Claim 12 depends from Claim 1. Claim 13 is independent. Claim 61 depends from Claim 47. Claim 82 depends from claim 74.

Substantial evidence is required of all factual findings, as discussed above. Absent substantial evidence, no *prima facie* case of obviousness exists.

The rejection of Group D is flawed because the Examiner has not made a *prima facie* case of obviousness:

- The Examiner has consistently ignored claim features generally directed to wherein *determining a package to be offered comprises selecting at least one secondary product based on at least one of (i) the profit margin of the primary product and (ii) the profit margin of the at least one secondary product*;
- The Examiner has failed to provide substantial evidence that any such feature was known at the time of invention; and
- The Examiner has failed to provide substantial evidence of a motivation to combine or modify the references to provide for such a feature.

##### **4.5.1. No substantial evidence of the limitations of Group D**

###### **No Factual Findings by the Examiner**

The Examiner has made no factual findings with respect to any of the additional limitations recited in Group D.

The closest the Examiner may come is where the Examiner states that:

Blinn discloses that a primary item in the database may be related to one or more secondary items in at least the following well known ways. See for example, To promote their products, merchants often discount their products or have sales. Merchants can use a wide variety of discounting schemes to

promote their products. For example, a merchant may offer volume discounts, such as buy two and get one free, or membership discounts where, for example frequent shoppers and AAA members get 10% off, or cross-sell incentives offering, for example, 50% off socks with a shoe purchase. Existing online merchant systems, such as Netscape Merchant System, support only date-based sale pricing, such as 20% off all shirts during the month of May. To enter the online shopping market, merchants desire an online merchant system that allows for a significantly wider variety of product discounting and sales schemes. Col. 1, lines 43-45.  
[Sixth Office Action, page 8] (Emphasis in original).

### No Substantial Evidence of the Limitations

The Examiner has not addressed the additional limitations recited in Group D. At best, the Examiner states that “a primary item in the database may be related to one or more secondary items in at least the following well known ways.” However, none of the “well known” ways stated in Blinn and relied upon by the Examiner even hints at wherein *determining a package to be offered comprises selecting at least one secondary product based on at least one of (i) the profit margin of the primary product and (ii) the profit margin of the at least one secondary product*, as generally recited in the claims of Group D.

Blinn in particular only describes retrieving from a database a cross-sell product that is associated with the product selected for purchase by the customer. Blinn does not describe or suggest selecting the cross-sell product based on any factor other than it being associated with the product selected for purchase, much less selecting it based on a profit margin (whether it be a profit margin of the product selected for purchase by the customer or the profit margin of the cross-sell product). Nothing in Blinn, or any other reference of record, teaches or suggests, alone or in combination, that profit margin has anything to do with selecting a product, much less selecting a secondary product, much less selecting a secondary product for a package offer.

Appellants have repeatedly read Blinn, Peirce, and Tice, and have found no hint that either reference teaches any of the additional limitations of Group D. Accordingly, there is no evidence, much less substantial evidence, of wherein *determining a package to be offered comprises selecting at least one secondary product based on at least one of (i) the profit margin of the primary product and (ii) the profit margin of the at least one secondary product*, as generally recited in the claims of Group D.

To the extent that the Examiner is relying solely upon Blinn, Peirce, or Tice as teaching the additional features recited in Group D, the Section 103(a) rejection cannot stand. The Examiner has failed to indicate any evidence of such features, much less substantial evidence.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness. Neither Blinn, Peirce, nor Tice, alone or in combination, can support any such rejection. The rejection of Group D fails for at least this reason.

#### **4.5.2. No showing of a proper motivation to combine the references**

The Examiner has failed to address any additional limitation of Group D or assert that either Blinn, Peirce, or Tice even hint at any additional limitation of Group D. Further, the Examiner simply has not even asserted any motivation to modify or combine the references to provide for the specific recited features of Group D, much less a motivation supported by the cited references or by substantial evidence of record.

The Examiner's Blinn-Peirce Motivation of pages 10-11 of the Sixth Office Action (discussed and traversed above) does not suggest specifically the desirability of providing for features generally directed to wherein *determining a package to be offered comprises selecting at least one secondary product based on*

*at least one of (i) the profit margin of the primary product and (ii) the profit margin of the at least one secondary product.* The Examiner does not assert otherwise.

Thus the Examiner has not shown substantial evidence of a motivation in the prior art of record to combine or modify the references in any manner that renders the claims of Group D obvious. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness. The rejection of Group D fails for at least this reason.

#### **4.5.3. Conclusion**

For any one of the above reasons, the Examiner has failed to establish a *prima facie* case of obviousness and the claims of Group D are patentable.

#### **4.6. Group E: Claims 18, 19, and 85**

Group E includes Claims **18, 19, and 85**.

Claims **18 and 19** depend from Claim 1. Claim **85** depends from Claim **74**.

Substantial evidence is required of all factual findings, as discussed above.

Absent substantial evidence, no *prima facie* case of obviousness exists.

The rejection of Group E is flawed because the Examiner has not made a *prima facie* case of obviousness:

- The Examiner has consistently ignored claim features generally directed to (i) *determining a discounted price for each at least one secondary product* and (ii) *summing the retail price of the primary product and the discounted price of the at least one secondary product to calculate the package price*;
- The Examiner has failed to provide substantial evidence that any such features were known at the time of invention; and
- The Examiner has failed to provide substantial evidence of a motivation to combine or modify the references to provide for such features.

##### **4.6.1. No substantial evidence of the limitations of Group E**

###### **Examiner's Factual Findings**

The Examiner does not explicitly address any statements to any claims of Group E.

The closest the Examiner comes to addressing Group E is a statement that “Blinn discloses that the combined package price is less than the sum of corresponding retail prices for the primary product and the at least one secondary product. See, for example, Fig. 11 and related text.” [Sixth Office Action, page 8].

###### **No Substantial Evidence of the Limitations**

The Examiner's statement and the cited portion of Blinn are not substantial evidence of the recited features of Group E.

The section of Blinn identified by the Examiner states:

the order engine 130 invokes the item price adjust stage of the order pipeline 131 to make any needed item price adjustments in the first annotated order 362. Because the ItemPromo component of the components 132 (FIG. 2) has been configured to apply 10% off of all items, it stores the "iadjust.sub.--currentprice" key-value pair on the item blackboard 372 of a second annotated order 374 to apply the 10% off promotion.

[Column 16, lines 56-61.]

Thus, a plain reading of the evidence asserted by the Examiner supports only an interpretation that Blinn teaches applying a blanket 10% discount to "all items."

Nothing in the cited portion hints at a package price that is a sum of a retail price and a discounted price—the described discount is for "all items." Thus, nothing in Blinn, or any of the other references of record, teaches or suggests determining a package price by (i) *determining a discounted price for each at least one secondary product and* (ii) *summing the retail price [or the discounted price] of the primary product and the discounted price of the at least one secondary product to calculate the package price*, as generally recited in Group E.

To the extent that the Examiner is relying solely upon Blinn, Peirce, or Tice as teaching any feature recited in claims **18, 19, and 85**, the Section 103(a) rejection cannot stand. The Examiner has failed to indicate any evidence of such features, much less substantial evidence.

To the extent that the Examiner is relying solely upon Blinn, Peirce, or Tice as teaching the additional features recited in Group E, the Section 103(a) rejection cannot stand. The Examiner has failed to indicate any evidence of such features, much less substantial evidence.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness. Neither Blinn, Peirce, nor Tice, alone or in combination, can support any such rejection. The rejection of Group E fails for at least this reason.

#### **4.6.2. No substantial evidence of a proper motivation to combine or modify the references**

The Examiner has failed to address any additional limitation of Group E or assert that either Blinn, Peirce, or Tice even hint at any additional limitation of Group E. Further, the Examiner simply has not even asserted any motivation to modify or combine the references to provide for the specific recited features of Group E, much less a motivation supported by the cited references or by substantial evidence of record.

The Examiner's Blinn-Peirce Motivation of pages 10-11 of the Sixth Office Action (discussed and traversed above) does not suggest specifically the desirability of providing for determining a package price by (i) *determining a discounted price for each at least one secondary product and* (ii) *summing the retail price [or the discounted price] of the primary product and the discounted price of the at least one secondary product to calculate the package price*. The Examiner does not assert otherwise.

Thus the Examiner has not shown substantial evidence of a motivation in the prior art of record to combine or modify the references in any manner that renders the claims of Group E obvious. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness. The rejection of Group E fails for at least this reason.

#### **4.6.3. Conclusion**

For any one of the above reasons, the Examiner has failed to establish a *prima facie* case of obviousness and the claims of Group E are patentable.



#### **4.7. Group F: Claims 20 and 86**

Group F includes Claims **20 and 86**.

Claim **20** depends from Claim **1**. Claim **86** depends from Claim **74**.

Substantial evidence is required of all factual findings, as discussed above.

Absent substantial evidence, no *prima facie* case of obviousness exists.

The rejection of Group F is flawed because the Examiner has not made a *prima facie* case of obviousness:

- the Examiner has consistently ignored the features generally directed to *wherein the discounted price for each of the at least one secondary product is based on a profit margin of the primary product*;
- the Examiner has failed to provide substantial evidence that any such features were known at the time of invention; and
- the Examiner has failed to provide substantial evidence of a motivation to combine or modify the references to provide for such features.

##### **4.7.1. No substantial evidence of the limitations of Group F**

###### **Examiner's Factual Findings**

The Examiner has made no factual findings with respect to the additional limitations recited in any of Group F. In fact, the Examiner has not asserted that either Blinn, Peirce, or Tice even hints at any specific limitation of Group F.

###### **No Substantial Evidence of the Limitations**

Appellants have repeatedly read Blinn, Peirce, and Tice, and have found no hint of any of the additional limitations of Group F. The Examiner does not specifically address any such limitations.

Nothing in Blinn, or any other reference of record, teaches or suggests, alone or in combination, that profit margin has anything to do with a discounted price, much less a discounted price of a secondary product, much less *wherein the discounted price for each of the at least one secondary product is based specifically on a profit margin of the primary product.*

To the extent that the Examiner is relying solely upon Blinn, Peirce, or Tice as teaching any feature recited in Group F, the Section 103(a) rejection cannot stand. The Examiner has failed to indicate any evidence of such features, much less substantial evidence.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness. Neither Blinn, Peirce, nor Tice, alone or in combination, can support any such rejection. The rejection of Group F fails for at least this reason.

**4.7.2. No substantial evidence of a proper motivation to combine or modify the references**

The Examiner has failed to address any additional limitation of Group F or assert that either Blinn, Peirce, or Tice even hint at any additional limitation of Group F. Further, the Examiner simply has not even asserted any motivation to modify or combine the references to provide for the specific recited features of Group F, much less a motivation supported by the cited references or by substantial evidence of record.

The Examiner's Blinn-Peirce Motivation of pages 10-11 of the Sixth Office Action (discussed and traversed above) does not suggest specifically the desirability of providing for *wherein the discounted price for each of the at least one secondary product is based on a profit margin of the primary product.* The Examiner does not assert otherwise.

Thus the Examiner has not shown substantial evidence of a motivation in the prior art of record to combine or modify the references in any manner that renders the claims of Group F obvious. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness. The rejection of Group F fails for at least this reason.

#### **4.7.3. Conclusion**

For any one of the above reasons, the Examiner has failed to establish a *prima facie* case of obviousness and the claims of Group F are patentable.

#### **4.8. Group G: Claims 23 and 88**

Group G includes Claims **23 and 88**.

Claim **23** depends from Claim **1**. Claim **88** depends from Claim **74**.

Substantial evidence is required of all factual findings, as discussed above.

Absent substantial evidence, no *prima facie* case of obviousness exists.

The rejection of Group G is flawed because the Examiner has not made a *prima facie* case of obviousness:

- the Examiner has consistently ignored the features generally directed to *wherein the discounted price for each of the primary product and the at least one secondary products is based on a profit margin of the primary product and a profit margin of the at least one secondary product;*
- the Examiner has failed to provide substantial evidence that any such features were known at the time of invention; and
- the Examiner has failed to provide substantial evidence of a motivation to combine or modify the references to provide for such features.

##### **4.8.1. No substantial evidence of the limitations of Group G**

###### **Examiner's Factual Findings**

The Examiner has made no factual findings with respect to the additional limitations recited in any of Group G. In fact, the Examiner has not asserted that either Blinn, Peirce, or Tice even hints at any specific limitation of Group G.

###### **No Substantial Evidence of the Limitations**

Appellants have repeatedly read Blinn, Peirce, and Tice, and have found no hint of any of the additional limitations of Group G. The Examiner does not specifically address any such limitations.

Nothing in Blinn, or any other reference of record, teaches or suggests, alone or in combination, that profit margin has anything to do with a discounted price, much less a discounted price of a secondary product, much less *wherein the discounted price for each of the at least one secondary product and the primary product are based specifically on a profit margin of the primary product and a profit margin of the at least one secondary product*.

To the extent that the Examiner is relying solely upon Blinn, Peirce, or Tice as teaching any feature recited in Group G, the Section 103(a) rejection cannot stand. The Examiner has failed to indicate any evidence of such features, much less substantial evidence.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness. Neither Blinn, Peirce, nor Tice, alone or in combination, can support any such rejection. The rejection of Group G fails for at least this reason.

**4.8.2. No substantial evidence of a proper motivation to combine or modify the references**

The Examiner has failed to address any additional limitation of Group G or assert that either Blinn, Peirce, or Tice even hint at any additional limitation of Group G. Further, the Examiner simply has not even asserted any motivation to modify or combine the references to provide for the specific recited features of Group G, much less a motivation supported by the cited references or by substantial evidence of record.

The Examiner's Blinn-Peirce Motivation of pages 10-11 of the Sixth Office Action (discussed and traversed above) does not suggest specifically the desirability of providing for *wherein the discounted price for each of the primary product and the at least one secondary products is based on a profit margin of the*

*primary product and a profit margin of the at least one secondary product.* The Examiner does not assert otherwise.

Thus the Examiner has not shown substantial evidence of a motivation in the prior art of record to combine or modify the references in any manner that renders the claims of Group G obvious. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness. The rejection of Group G fails for at least this reason.

#### **4.8.3. Conclusion**

For any one of the above reasons, the Examiner has failed to establish a *prima facie* case of obviousness and the claims of Group G are patentable.

#### **4.9. Group H: Claims 24 and 89**

Group H includes Claims **24** and **89**.

Claim **23** depends from Claim **1**. Claim **88** depends from Claim **74**.

Substantial evidence is required of all factual findings, as discussed above.

Absent substantial evidence, no *prima facie* case of obviousness exists.

The rejection of Group H is flawed because the Examiner has not made a *prima facie* case of obviousness:

- the Examiner has consistently ignored the features generally directed to *receiving a customer response indicating a rejection of the package offer and in response to the customer response, determining another package to be offered to the customer*;
- the Examiner has failed to provide substantial evidence that any such features were known at the time of invention; and
- the Examiner has failed to provide substantial evidence of a motivation to combine or modify the references to provide for such features.

##### **4.9.1. No substantial evidence of the limitations of Group H**

###### **Examiner's Factual Findings**

The Examiner has made no factual findings with respect to the additional limitations recited in Group H. The Examiner has neither addressed the limitations of Group H nor asserted that any of the cited references even hints at any response to a rejection of a package, much less determining another package to offer to the customer, as generally provided for in Group H.

###### **No Substantial Evidence of the Limitations**

Appellants have repeatedly read Blinn, Peirce, and Tice and have found no hint of any of the additional limitations of Group H. The Examiner does not specifically address any such limitations.

Blinn, in particular, does not describe or suggest determining another cross-sell product if a customer rejects an offer of a first cross-sell product. In Blinn, any and all cross-sell products associated with a product selected for purchase by the customer would be offered to the customer at the same time. Blinn does not describe offering only one cross-sell product and then offering another if the customer rejects the first offer. In fact, Blinn does not address at all what action to take if the customer rejects an offer of a cross-sell product.

To the extent that the Examiner is relying solely upon Blinn, Peirce, or Tice as teaching the additional features recited in Group H, the Section 103(a) rejection cannot stand. The Examiner has failed to indicate any evidence of such features, much less substantial evidence.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness. Neither Blinn, Peirce, nor Tice, alone or in combination, can support any such rejection. The rejection of Group H fails for at least this reason.

**4.9.2. No substantial evidence of a proper motivation to combine or modify the references**

The Examiner has failed to address any additional limitation of Group H or assert that either Blinn, Peirce, or Tice even hint at any additional limitation of Group H. Further, the Examiner simply has not even asserted any motivation to modify or combine the references to provide for the specific recited features of Group H, much less a motivation supported by the cited references or by substantial evidence of record.



The Examiner's Blinn-Peirce Motivation of pages 10-11 of the Sixth Office Action (discussed and traversed above) does not suggest specifically the desirability of providing for features generally directed to *receiving a customer response indicating a rejection of the package offer and in response to the customer response, determining another package to be offered to the customer*. The Examiner does not assert otherwise.

Thus the Examiner has not shown substantial evidence of a motivation in the prior art of record to combine or modify the references in any manner that renders the claims of Group H obvious. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness. The rejection of Group H fails for at least this reason.

#### **4.9.3. Conclusion**

For any one of the above reasons, the Examiner has failed to establish a *prima facie* case of obviousness and the claims of Group H are patentable.

#### **4.10. Group I: Claims 29, 30, and 93**

Group I includes Claims **29, 30, and 93**.

Claim **29** depends from Claim **1**. Claim **30** is independent. Claim **93** depends from Claim **74**.

Substantial evidence is required of all factual findings, as discussed above. Absent substantial evidence, no *prima facie* case of obviousness exists.

The rejection of Group I is flawed because the Examiner has not made a *prima facie* case of obviousness:

- the Examiner has consistently ignored the features generally directed to *wherein the package offer comprises an offer for sale of a pre-determined number of the secondary products, selected by the customer, at the package price*;
- the Examiner has failed to provide substantial evidence that any such features were known at the time of invention; and
- the Examiner has failed to provide substantial evidence of a motivation to combine or modify the references to provide for such features.

##### **4.10.1. No substantial evidence of the limitations of Group I**

###### **Examiner's Factual Findings**

The Examiner has made no factual findings with respect to the additional limitations recited in Group I. The Examiner has neither addressed the limitations of Group I nor asserted that any of the cited references even hints at an offer to sell a pre-determined number of secondary products, selected by a customer, at a package price, as generally provided for in Group I.

###### **No Substantial Evidence of the Limitations**

Appellants have repeatedly read Blinn, Peirce, and Tice and have found no hint of any such features of Group I. The Examiner does not specifically address any such limitations.

Blinn, in particular, does not describe or suggest the above feature. Blinn merely describes that a cross-sell product may be offered to the customer when the customer selects a product for purchase. Blinn does not describe presenting to the customer a selection of cross-sell products, where the customer may select a number of the cross-sell products for a particular package price. Even if Blinn were interpreted as describing that more than one cross-sell product may be offered to the customer, Blinn does not describe allowing the customer to select a number of the cross-sell products for a particular package price. Rather, the total price that a customer would pay for selecting more than one cross-sell product would vary based on the individual prices of the cross-sell products selected. In contrast, in the claimed embodiments the package price may remain unaffected by the particular secondary products selected.

To the extent that the Examiner is relying solely upon Blinn, Peirce, or Tice as teaching the additional features recited in Group I, the Section 103(a) rejection cannot stand. The Examiner has failed to indicate any evidence of such features, much less substantial evidence.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness. Neither Blinn, Peirce, nor Tice, alone or in combination, can support any such rejection. The rejection of Group I fails for at least this reason.

**4.10.2. No substantial evidence of a proper motivation to combine or modify the references**

The Examiner has failed to address any additional limitation of Group I or assert that either Blinn, Peirce, or Tice even hint at any additional limitation of

Group I. Further, the Examiner simply has not even asserted any motivation to modify or combine the references to provide for the specific recited features of Group I, much less a motivation supported by the cited references or by substantial evidence of record.

The Examiner's Blinn-Peirce Motivation of pages 10-11 of the Sixth Office Action (discussed and traversed above) does not suggest specifically the desirability of providing for features generally directed to *wherein the package offer comprises an offer for sale of a pre-determined number of the secondary products, selected by the customer, at the package price*. The Examiner does not assert otherwise.

Thus the Examiner has not shown substantial evidence of a motivation in the prior art of record to combine or modify the references in any manner that renders the claims of Group I obvious. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness. The rejection of Group I fails for at least this reason.

#### 4.10.3. Conclusion

For any one of the above reasons, the Examiner has failed to establish a *prima facie* case of obviousness and the claims of Group I are patentable.

#### **4.11. Group J: Claims 31, 94, and 95**

Group J includes Claims **31, 94, and 95**.

Claim **31** depends from Claim **1**. Claim **94** depends from Claim **74**. Claim **95** depends from Claim **94**.

Substantial evidence is required of all factual findings, as discussed above. Absent substantial evidence, no *prima facie* case of obviousness exists.

The rejection of Group J is flawed because the Examiner has not made a *prima facie* case of obviousness:

- the Examiner has consistently ignored the features generally directed to *wherein the package offer comprises an offer for sale of a customer-selected number of the secondary products, selected by the customer, at the package price*;
- the Examiner has failed to provide substantial evidence that any such features were known at the time of invention; and
- the Examiner has failed to provide substantial evidence of a motivation to combine or modify the references to provide for such features.

##### **4.11.1. No substantial evidence of the limitations of Group J**

###### **Examiner's Factual Findings**

The Examiner has made no factual findings with respect to the additional limitations recited in Group J. The Examiner has neither addressed the limitations of Group J nor asserted that any of the cited references even hints at an offer to sell a customer-selected number of secondary products, selected by a customer, at a package price, as generally provided for in Group J.

###### **No Substantial Evidence of the Limitations**

Some embodiments of the present invention provide for a customer to be offered a number of secondary products at a package price, in which the offer includes allowing the customer to select both the particular secondary products and the number of secondary products to be selected at a package price.

Appellants have repeatedly read Blinn, Peirce, and Tice and have found no hint of any such features of Group J. The Examiner does not specifically address any such limitations.

Blinn, in particular, does not describe or suggest the above feature. Blinn merely describes that a cross-sell product may be offered to the customer when the customer selects a product for purchase. Blinn does not describe presenting to the customer a selection of cross-sell products, where the customer may select a number of the cross-sell products for a particular package price. Even if Blinn were interpreted as describing that more than one cross-sell product may be offered to the customer, Blinn does not describe allowing the customer to select a number of the cross-sell products for a particular package price. Rather, the total price that a customer would pay for selecting more than one cross-sell product would vary based on the individual prices of the cross-sell products selected. In contrast, in the claimed embodiments the package price may remain unaffected by the particular secondary products selected.

To the extent that the Examiner is relying solely upon Blinn, Peirce, or Tice as teaching the additional features recited in Group J, the Section 103(a) rejection cannot stand. The Examiner has failed to indicate any evidence of such features, much less substantial evidence.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness. Neither Blinn, Peirce, nor Tice, alone or in combination, can support any such rejection. The rejection of Group J fails for at least this reason.

#### **4.11.2. No substantial evidence of a proper motivation to combine or modify the references**

The Examiner has failed to address any additional limitation of Group J or assert that either Blinn, Peirce, or Tice even hint at any additional limitation of Group J. Further, the Examiner simply has not even asserted any motivation to modify or combine the references to provide for the specific recited features of Group J, much less a motivation supported by the cited references or by substantial evidence of record.

The Examiner's Blinn-Peirce Motivation of pages 10-11 of the Sixth Office Action (discussed and traversed above) does not suggest specifically the desirability of providing for features generally directed to *wherein the package offer comprises an offer for sale of a customer-selected number of the secondary products, selected by the customer, at the package price*. The Examiner does not assert otherwise.

Thus the Examiner has not shown substantial evidence of a motivation in the prior art of record to combine or modify the references in any manner that renders the claims of Group J obvious. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness. The rejection of Group J fails for at least this reason.

#### **4.11.3. Conclusion**

For any one of the above reasons, the Examiner has failed to establish a *prima facie* case of obviousness and the claims of Group J are patentable.

#### **4.12. Group K: Claims 32 and 33**

32. The method of claim 29, wherein the package price varies based on the customer-selected number of secondary products.

33. A computer-readable medium having stored thereon computer-executable instructions for performing the method of claim 32.

Group K includes Claims **32 and 33**.

Claim **32** depends from Claim **29**, which depends from Claim **1**. Claim **33** is independent and includes all of the limitations of Claim **31**.

Substantial evidence is required of all factual findings, as discussed above. Absent substantial evidence, no *prima facie* case of obviousness exists.

The rejection of Group K is flawed because the Examiner has not made a *prima facie* case of obviousness:

- the Examiner has consistently ignored the features generally directed to (i) *wherein the package offer comprises an offer for sale of a customer-selected number of the secondary products, selected by the customer, at the package price* and (ii) *wherein the package price varies based on the customer-selected number of secondary products*;
- the Examiner has failed to provide substantial evidence that any such features were known at the time of invention; and
- the Examiner has failed to provide substantial evidence of a motivation to combine or modify the references to provide for such features.

##### **4.12.1. No substantial evidence of the limitations of Group K**

##### **Examiner's Factual Findings**



The Examiner has made no factual findings with respect to the additional limitations recited in Group K. The Examiner has neither addressed the limitations of Group K nor asserted that any of the cited references even hints at an offer to sell a customer-selected number of secondary products, selected by a customer, at a package price, much less in which the package price varies based on the customer-selected number, as generally provided for in Group K.

### No Substantial Evidence of the Limitations

Some embodiments of the present invention provide for a customer to be offered a number of secondary products at a package price, in which the offer includes allowing the customer to select both the particular secondary products and the number of secondary products to be selected at a package price. In one embodiment, as recited in Group K, the package price varies based on the customer-selected number.

Appellants have repeatedly read Blinn, Peirce, and Tice and have found no hint of any such features of Group K. The Examiner does not specifically address any such limitations.

Blinn, in particular, does not describe or suggest the above feature. Blinn merely describes that a cross-sell product may be offered to the customer when the customer selects a product for purchase. Blinn does not describe presenting to the customer a selection of cross-sell products, where the customer may select a number of the cross-sell products for a particular package price. Even if Blinn were interpreted as describing that more than one cross-sell product may be offered to the customer, Blinn does not describe allowing the customer to select a number of the cross-sell products for a particular package price. Rather, the total price that a customer would pay for selecting more than one cross-sell product would vary based on the individual prices of the cross-sell products selected. In contrast, in

the claimed embodiments the package price may remain unaffected by the particular secondary products selected.

To the extent that the Examiner is relying solely upon Blinn, Peirce, or Tice as teaching the additional features recited in Group K, the Section 103(a) rejection cannot stand. The Examiner has failed to indicate any evidence of such features, much less substantial evidence.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness. Neither Blinn, Peirce, nor Tice, alone or in combination, can support any such rejection. The rejection of Group K fails for at least this reason.

**4.12.2. No substantial evidence of a proper motivation to combine or modify the references**

The Examiner has failed to address any additional limitation of Group K or assert that either Blinn, Peirce, or Tice even hint at any additional limitation of Group K. Further, the Examiner simply has not even asserted any motivation to modify or combine the references to provide for the specific recited features of Group K, much less a motivation supported by the cited references or by substantial evidence of record.

The Examiner's Blinn-Peirce Motivation of pages 10-11 of the Sixth Office Action (discussed and traversed above) does not suggest specifically the desirability of providing for features generally directed to (i) *wherein the package offer comprises an offer for sale of a customer-selected number of the secondary products, selected by the customer, at the package price* and (ii) *wherein the package price varies based on the customer-selected number of secondary products*. The Examiner does not assert otherwise.

Thus the Examiner has not shown substantial evidence of a motivation in the prior art of record to combine or modify the references in any manner that renders

the claims of Group K obvious. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness. The rejection of Group K fails for at least this reason.

#### **4.12.3. Conclusion**

For any one of the above reasons, the Examiner has failed to establish a *prima facie* case of obviousness and the claims of Group K are patentable.

#### **4.13. Group L: Claims 34, 35, and 96**

Group L includes Claims **34, 35, and 96**.

Claim **34** depends from Claim **1**. Claim **35** is independent. Claim **96** depends from Claim **74**.

Substantial evidence is required of all factual findings, as discussed above. Absent substantial evidence, no *prima facie* case of obviousness exists.

The rejection of Group L is flawed because the Examiner has not made a *prima facie* case of obviousness:

- the Examiner has consistently ignored the features generally directed to (i) *wherein the package comprises the primary product and a plurality of lists of secondary products* and (ii) *wherein the package offer comprises an offer for sale of a pre-determined number of the secondary products selected by the customer from each of the plurality of lists, at the package price*;
- the Examiner has failed to provide substantial evidence that any such features were known at the time of invention; and
- the Examiner has failed to provide substantial evidence of a motivation to combine or modify the references to provide for such features.

##### **4.13.1. No substantial evidence of the limitations of Group L**

##### **Examiner's Factual Findings**

The Examiner has made no factual findings with respect to the additional limitations recited in Group L. The Examiner has neither addressed the limitations of Group L nor asserted that any of the cited references even hints at an offer to sell a pre-determined number of secondary products, selected by a customer, at a package price, as generally provided for in Group L.

### No Substantial Evidence of the Limitations

Some embodiments of the present invention allow for a customer to be provided a package offer comprising an offer for sale of a pre-determined number of the secondary products, selected by the customer, from each of the plurality of lists, at the package price. For example, a package may include a primary product “A” and a first list “1” that includes products “B” and “C” and a second list “2” that includes products “D” and “E”. The customer may be presented with an offer to purchase product “A” plus one of the products from list “1” and one product from list “2”, all for the price of \$25. Thus, the customer could select to purchase products “A”, “B” and “D” for \$25 or products “A”, “B” and “E” for \$25 or products “A”, “C” and “D” for \$25 or products “A”, “C” and “E” for \$25. Neither Blinn or any other prior art of record teaches or suggests such an embodiment. As discussed above, Blinn merely describes offering a customer a cross-sell product once the customer selects a product for purchase. Blinn does not describe allowing the customer to select more than one cross-sell product, much less allowing the customer to select one product from each of a plurality of lists of products, much less allowing the customer to do so all for a particular package price.

Appellants have repeatedly read Blinn, Peirce, and Tice and have found no hint of any such features of Group L. The Examiner does not specifically address any such limitations.

To the extent that the Examiner is relying solely upon Blinn, Peirce, or Tice as teaching the additional features recited in Group L, the Section 103(a) rejection cannot stand. The Examiner has failed to indicate any evidence of such features, much less substantial evidence.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness. Neither Blinn, Peirce, nor Tice, alone or in combination, can support any such rejection. The rejection of Group L fails for at least this reason.

#### **4.13.2. No substantial evidence of a proper motivation to combine or modify the references**

The Examiner has failed to address any additional limitation of Group L or assert that either Blinn, Peirce, or Tice even hint at any additional limitation of Group L. Further, the Examiner simply has not even asserted any motivation to modify or combine the references to provide for the specific recited features of Group L, much less a motivation supported by the cited references or by substantial evidence of record.

The Examiner's Blinn-Peirce Motivation of pages 10-11 of the Sixth Office Action (discussed and traversed above) does not suggest specifically the desirability of providing for features generally directed to (i) *wherein the package comprises the primary product and a plurality of lists of secondary products* and (ii) *wherein the package offer comprises an offer for sale of a pre-determined number of the secondary products selected by the customer from each of the plurality of lists, at the package price*. The Examiner does not assert otherwise.

Thus the Examiner has not shown substantial evidence of a motivation in the prior art of record to combine or modify the references in any manner that renders the claims of Group L obvious. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness. The rejection of Group L fails for at least this reason.

#### **4.13.3. Conclusion**

For any one of the above reasons, the Examiner has failed to establish a *prima facie* case of obviousness and the claims of Group L are patentable.

#### **4.14. Group M: Claims 39, 100, and 116**

Group M includes Claims **39, 100, and 116**.

Claim **39** depends from Claims **1, 36, 37, and 38**. Claim **100** depends from Claims **74, 97, 98, and 99**. Claim **116** depends from Claim **108**.

Substantial evidence is required of all factual findings, as discussed above. Absent substantial evidence, no *prima facie* case of obviousness exists.

The rejection of Group M is flawed because the Examiner has not made a *prima facie* case of obviousness:

- the Examiner has failed to provide substantial evidence that any of the following features were known at the time of invention: *wherein the printed version comprises a code identifying the package offer and product identifiers for the primary product and the at least one secondary product included in the package*; and
- the Examiner has failed to provide substantial evidence of a motivation to combine or modify the references to provide for such features.

##### **4.14.1. No substantial evidence of the limitations of Group M**

###### **Examiner's Factual Findings**

The Examiner asserts: "Blinn discloses that [sic] customer may be at interactive kiosks (for example, Col. 6, lines 9-24)." The Examiner then recites the following unsupported assertions about kiosks:

1. "Kiosks are often found at related retailer stores."
2. "While in a merchant's store at a local shopping center, a customer may use a kiosk to access the system and purchase additional items."
3. "A customer may do this possibly to take advantage of discounts that are available on-line and in combination with another merchant's products."

4. “Using a mall or a store’s kiosk, a customer may”
  - (a) “order items,”
  - (b) “pay for them and”
  - (c) “obtain a printed copy of a coded receipt.”
5. “The customer may present coded receipts to merchants who may”
  - (a) “verify payment of the package order, and”
  - (b) “deliver the items.”

[Sixth Office Action, page 9].

The Examiner admits that ‘Blinn *does not* use the term bar code or Point of Sale Terminal. While Blinn discloses the use of a printed copy and online checkout receipt, Blinn *does not* specifically state that a printed receipt may include information in bar code formats.’ Presumably as a result of the Examiner’s inability or unwillingness to identify such subject matter in the prior art of record, the Examiner resorts to taking “official notice that [(i)] bar codes and Point of Sales [sic] terminals are well known to one of ordinary skill in the art, and that [(ii)] printed receipts and coupons often contain bar-coded information. [(iii)] Such information may include store or item specific information such as store id, item id, receipt or transaction information.’ [Sixth Office Action, page 10 (notation added)].

#### No Substantial Evidence of the Limitations

The Examiner has not provided substantial evidence of the above-mentioned features of Group M.

The brief mention of “interactive kiosk” in Blinn cannot support the Examiner’s rejection. “Interactive kiosk” is recited as one example of “client 100,” which is described in that portion as a “general purpose computer.” There is no hint in the cited portion, or otherwise in Blinn, that an interactive kiosk would



have been understood by one having ordinary skill in the art as necessarily providing for *a code identifying (i) the package offer and (ii) product identifiers for (a) the primary product and (b) the at least one secondary product included in the package.*

The Examiner apparently recognized this failure of Blinn and attempted to bolster the rejection with the series of unsupported assertions about “kiosks” and “bar codes and Point of Sales terminals.”

The continuing lack of support for any of those assertions, Appellants’ prompt traversal of those assertions, and Appellants’ argument that the assertions do not constitute substantial evidence, are discussed above. [See, Subject Matter Without Support in the Record]. Subject matter without any evidentiary basis in the record cannot be used as the basis for a rejection under Section 103. As such, any rejection of Group M based upon the Examiner’s assertions as to the alleged functionality of apparatus that allegedly could be “often found at related retailer stores” cannot stand for failure to establish a *prima facie* case.

Appellants further (again) traverse any unsupported assertion by the Examiner that it was known to those of only ordinary skill in the art at the time of the present invention to produce, “at related retailer stores,” “a printed copy of a coded receipt” that could be presented to a merchant “who may verify payment of the package order, and deliver the items.”

Appellants further (again) traverse any unsupported assertion by the Examiner that it was known to those of only ordinary skill in the art at the time of the present invention to produce a bar code (or other type of code) *identifying (i) the package offer and (ii) product identifiers for (a) the primary product and (b) the at least one secondary product included in the package.*

Absent any evidentiary support for the Examiner's assertions of what was "often found" or "well known," at present the record indicates only that the asserted subject matter was

- (i) known to the Examiner (who had the benefit of the present disclosure),
- (ii) at the time the Sixth Office Action was authored.

Further, whether or not the assertions are supported by substantial evidence, nothing in those assertions suggests specifically *a code identifying (i) the package offer and (ii) product identifiers for (a) the primary product and (b) the at least one secondary product included in the package*. Accordingly, the Examiner has not even asserted that the explicitly claimed subject matter was known at the time of invention to one of ordinary skill in the art.

To the extent that the Examiner is relying solely upon Blinn, Peirce, or Tice (and/or unsupported assertions) as teaching the additional features recited in Group M, the Section 103(a) rejection cannot stand. The Examiner has failed to indicate any evidence of such features, much less substantial evidence.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness. Neither Blinn, Peirce, nor Tice, alone or in combination, can support any such rejection. The rejection of Group M fails for at least this reason.

**4.14.2. No substantial evidence of a proper motivation to combine or modify the references**

The Examiner has failed to establish substantial evidence of the features of Group M.

Similarly, the Examiner has failed to provide any evidence in support of a motivation to modify any combination of the cited references to provide for either the "kiosks" or the "bar codes and Point of Sales terminals" described in the Examiner's unsupported assertions.

The Examiner's states only that there is an allegedly "obvious reason" to provide for the asserted subject matter: "bar codes make it possible to read information directly into a computer and to transact business in a more efficient manner, including at least avoidance of human error and illegible handwriting." [Sixth Office Action, page 10].

As the record is devoid of any support for either what the Examiner asserts was "well known" or what allegedly is an "obvious reason" to use bar codes, the Examiner simply has not provided substantial evidence of any motivation to modify or combine the references to provide for either the asserted subject matter or the specific recited features of Group M. Further, as discussed above, even if a motivation to provide for the asserted subject matter had been properly supported, the modification would not have provided specifically for the claimed subject matter.

Thus the Examiner has not shown substantial evidence of a motivation in the prior art of record to combine or modify the references in any manner that renders the claims of Group M obvious. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness. The rejection of Group M fails for at least this reason.

#### **4.14.3. Conclusion**

For any one of the above reasons, the Examiner has failed to establish a *prima facie* case of obviousness and the claims of Group M are patentable.

#### **4.15. Group N: Claims 40, 66, and 101**

Group N includes Claims **40, 66, and 101**.

Claim **40** depends from Claims **1, 36, and 37**. Claim **66** depends from Claims **47, 58, and 64**. Claim **101** depends from Claims **74, 97, and 98**.

Substantial evidence is required of all factual findings, as discussed above. Absent substantial evidence, no *prima facie* case of obviousness exists.

The rejection of Group N is flawed because the Examiner has not made a *prima facie* case of obviousness:

- the Examiner has consistently ignored the features generally directed to (i) *wherein the customer device comprises a customer service device at a retail establishment*, (ii) *wherein the customer service device comprises an input device operable to input the primary product identifier and a display device operable to present the package offer*; and (iii) *wherein the input device comprises a bar code reader*;
- the Examiner has failed to provide substantial evidence that any such features were known at the time of invention; and
- the Examiner has failed to provide substantial evidence of a motivation to combine or modify the references to provide for such features.

##### **4.15.1. No substantial evidence of the limitations of Group N**

##### **Examiner's Factual Findings**

The Examiner admits that 'Blinn *does not* use the term bar code or Point of Sale Terminal. While Blinn discloses the use of a printed copy and online checkout receipt, Blinn *does not* specifically state that a printed receipt may include information in bar code formats.' Presumably as a result of the Examiner's inability or unwillingness to identify such subject matter in the prior

art of record, the Examiner resorts to taking “official notice that [(i)] bar codes and Point of Sales [sic] terminals are well known to one of ordinary skill in the art, and that [(ii)] printed receipts and coupons often contain bar-coded information. [(iii)] Such information may include store or item specific information such as store id, item id, receipt or transaction information.’ [Sixth Office Action, page 10 (notation added)].

### No Substantial Evidence of the Limitations

In apparent recognition of the failure of Blinn (or the other cited references) to provide for the features of Group N, the Examiner attempted to bolster the rejection with the series of unsupported assertions about “bar codes and Point of Sales terminals.”

The continuing lack of support for any of those assertions, Appellants’ prompt traversal of those assertions, and Appellants’ argument that the assertions do not constitute substantial evidence, are discussed above. [See, Subject Matter Without Support in the Record]. Subject matter without any evidentiary basis in the record cannot be used as the basis for a rejection under Section 103. As such, any rejection of Group N based upon the Examiner’s assertions as to the alleged functionality of apparatus that allegedly is “well known” cannot stand for failure to establish a *prima facie* case.

Appellants traverse any unsupported assertion by the Examiner that it was known to those of only ordinary skill in the art at the time of the present invention to provide for *wherein the customer device comprises a customer service device at a retail establishment, (ii) wherein the customer service device comprises an input device operable to input the primary product identifier and a display device operable to present the package offer; and (iii) wherein the input device comprises a bar code reader.*

Absent any evidentiary support for the Examiner's assertions of what was "often found" or "well known," at present the record indicates only that the asserted subject matter was

- (i) known to the Examiner (who had the benefit of the present disclosure),
- (ii) at the time the Sixth Office Action was authored.

Further, whether or not the assertions are supported by substantial evidence, nothing in those assertions suggests specifically *wherein the customer device comprises a customer service device at a retail establishment*, (ii) *wherein the customer service device comprises an input device operable to input the primary product identifier and a display device operable to present the package offer*; and (iii) *wherein the input device comprises a bar code reader*. In particular, the Examiner's assertions appear to be directed to outputting bar codes, not *wherein an input device comprises a bar code reader*. Accordingly, the Examiner has not even asserted that the explicitly claimed subject matter was known at the time of invention to one of ordinary skill in the art.

To the extent that the Examiner is relying solely upon Blinn, Peirce, or Tice (and/or unsupported assertions) as teaching the additional features recited in Group N, the Section 103(a) rejection cannot stand. The Examiner has failed to indicate any evidence of such features, much less substantial evidence.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness. Neither Blinn, Peirce, nor Tice, alone or in combination, can support any such rejection. The rejection of Group N fails for at least this reason.

**4.15.2. No substantial evidence of a proper motivation to combine or modify the references**

The Examiner has failed to establish substantial evidence of the features of Group N.

Similarly, the Examiner has failed to provide any evidence in support of the allegedly “obvious reason” to provide for the claimed subject matter: “bar codes make it possible to read information directly into a computer and to transact business in a more efficient manner, including at least avoidance of human error and illegible handwriting.” [Sixth Office Action, page 10].

The Examiner does not provide any evidence in support of a motivation suggesting that it would be desirable to modify any combination of the cited references to “make it possible to read information directly into a computer,” much less why such a modification would provide for the specifically recited subject matter of Group N.

As the record is devoid of any support for either what the Examiner asserts was “well known” or what allegedly is an “obvious reason” to use bar codes, the Examiner simply has not provided substantial evidence of any motivation to modify or combine the references to provide for the specific recited features of Group N.

Thus the Examiner has not shown substantial evidence of a motivation in the prior art of record to combine or modify the references in any manner that renders the claims of Group N obvious. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness. The rejection of Group N fails for at least this reason.

#### **4.15.3. Conclusion**

For any one of the above reasons, the Examiner has failed to establish a *prima facie* case of obviousness and the claims of Group N are patentable.

#### **4.16. Group O: Claim 42**

Group O includes Claim 42.

Claim 42 depends from Claims 1 and 41.

Substantial evidence is required of all factual findings, as discussed above. Absent substantial evidence, no *prima facie* case of obviousness exists.

The rejection of Group O is flawed because the Examiner has not made a *prima facie* case of obviousness:

- the Examiner has consistently ignored the features (i) *receiving from a point of sale terminal a customer response indicating an account identifier and an acceptance of the package offer*; (ii) *in response to the customer response, authorizing the point of sale terminal to charge a financial account identified by the account identifier for the amount of the package price*; and (iii) *wherein the customer response further indicates a code identifying the package offer and product identifiers for the primary product and the at least one secondary product included in the package*;
- the Examiner has failed to provide substantial evidence that any such features were known at the time of invention; and
- the Examiner has failed to provide substantial evidence of a motivation to combine or modify the references to provide for such features.

##### **4.16.1. No substantial evidence of the limitations of Group O**

###### **Examiner's Factual Findings**

The Examiner asserts: "Blinn discloses that [sic] customer may be at interactive kiosks (for example, Col. 6, lines 9-24)." The Examiner then recites the following unsupported assertions about kiosks:

1. "Kiosks are often found at related retailer stores."



2. “While in a merchant’s store at a local shopping center, a customer may use a kiosk to access the system and purchase additional items.”
3. “A customer may do this possibly to take advantage of discounts that are available on-line and in combination with another merchant’s products.”
4. “Using a mall or a store’s kiosk, a customer may”
  - (a) “order items,”
  - (b) “pay for them and”
  - (c) “obtain a printed copy of a coded receipt.”
5. “The customer may present coded receipts to merchants who may”
  - (a) “verify payment of the package order, and”
  - (b) “deliver the items.”

[Sixth Office Action, page 9].

The Examiner admits that ‘Blinn *does not* use the term bar code or Point of Sale Terminal. While Blinn discloses the use of a printed copy and online checkout receipt, Blinn *does not* specifically state that a printed receipt may include information in bar code formats.’ Presumably as a result of the Examiner’s inability or unwillingness to identify such subject matter in the prior art of record, the Examiner resorts to taking “official notice that [(i)] bar codes and Point of Sales [sic] terminals are well known to one of ordinary skill in the art, and that [(ii)] printed receipts and coupons often contain bar-coded information. [(iii)] Such information may include store or item specific information such as store id, item id, receipt or transaction information.’ [Sixth Office Action, page 10 (notation added)].

#### No Substantial Evidence of the Limitations

The Examiner has not provided substantial evidence of the above-mentioned features of Group O.

The brief mention of “interactive kiosk” in Blinn cannot support the Examiner’s rejection. “Interactive kiosk” is recited as one example of “client 100,” which is described in that portion as a “general purpose computer.” There is no hint in the cited portion, or otherwise in Blinn, that an interactive kiosk would have been understood by one having ordinary skill in the art as necessarily providing for *receiving from a point of sale terminal a customer response indicating (A) an account identifier (B) an acceptance of the package offer and (C) a code identifying (i) the package offer and (ii) product identifiers for (a) the primary product and (b) the at least one secondary product included in the package.*

The Examiner apparently recognized this failure of Blinn and attempted to bolster the rejection with the series of unsupported assertions about “kiosks” and “bar codes and Point of Sales terminals.”

The continuing lack of support for any of those assertions, Appellants’ prompt traversal of those assertions, and Appellants’ argument that the assertions do not constitute substantial evidence, are discussed above. [See, Subject Matter Without Support in the Record]. Subject matter without any evidentiary basis in the record cannot be used as the basis for a rejection under Section 103. As such, any rejection of Group O based upon the Examiner’s assertions as to the alleged functionality of apparatus that allegedly could be “often found at related retailer stores” cannot stand for failure to establish a *prima facie* case.

Appellants further (again) traverse any unsupported assertion by the Examiner that it was known to those of only ordinary skill in the art at the time of the present invention to produce, “at related retailer stores,” “a printed copy of a coded receipt” that could be presented to a merchant “who may verify payment of the package order, and deliver the items.”

Appellants further (again) traverse any unsupported assertion by the Examiner that it was known to those of only ordinary skill in the art at the time of the present invention to produce a bar code (or other type of code) *identifying (i) the package offer and (ii) product identifiers for (a) the primary product and (b) the at least one secondary product included in the package, or that a customer response received from a point of sale terminal would indicate such a code (in addition to an acceptance of a package offer and an account identifier).*

Absent any evidentiary support for the Examiner's assertions of what was "often found" or "well known," at present the record indicates only that the asserted subject matter was

- (i) known to the Examiner (who had the benefit of the present disclosure),
- (ii) at the time the Sixth Office Action was authored.

Further, whether or not the assertions are supported by substantial evidence, nothing in those assertions suggests specifically *receiving from a point of sale terminal a customer response indicating (A) an account identifier (B) an acceptance of the package offer and (C) a code identifying (i) the package offer and (ii) product identifiers for (a) the primary product and (b) the at least one secondary product included in the package.* Accordingly, the Examiner has not even asserted that the explicitly claimed subject matter was known at the time of invention to one of ordinary skill in the art.

To the extent that the Examiner is relying solely upon Blinn, Peirce, or Tice (and/or unsupported assertions) as teaching the additional features recited in Group O, the Section 103(a) rejection cannot stand. The Examiner has failed to indicate any evidence of such features, much less substantial evidence.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness. Neither Blinn, Peirce, nor Tice, alone or in combination, can support any such rejection. The rejection of Group O fails for at least this reason.

**4.16.2. No substantial evidence of a proper motivation to combine or modify the references**

The Examiner has failed to establish substantial evidence of the features of Group O.

Similarly, the Examiner has failed to provide any evidence in support of a motivation to modify any combination of the cited references to provide for either the “kiosks” or the “bar codes and Point of Sales terminals” described in the Examiner’s unsupported assertions.

The Examiner’s states only that there is an allegedly “obvious reason” to provide for the asserted subject matter: “bar codes make it possible to read information directly into a computer and to transact business in a more efficient manner, including at least avoidance of human error and illegible handwriting.” [Sixth Office Action, page 10].

The Examiner does not provide any evidence in support of a motivation suggesting that it would desirable to modify any combination of the cited references to “make it possible to read information directly into a computer,” much less why such a modification would provide for the specifically recited subject matter of Group O.

As the record is devoid of any support for either what the Examiner asserts was “well known” or what allegedly is an “obvious reason” to use “bar codes and Point of Sales terminals,” the Examiner simply has not provided substantial evidence of any motivation to modify or combine the references to provide for either the asserted subject matter or the specific recited features of Group O. Further, as discussed above, even if a motivation to provide for the asserted subject matter had been properly supported, the modification would not have provided specifically for the claimed subject matter.

Thus the Examiner has not shown substantial evidence of a motivation in the prior art of record to combine or modify the references in any manner that renders the claims of Group O obvious. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness. The rejection of Group O fails for at least this reason.

#### **4.16.3. Conclusion**

For any one of the above reasons, the Examiner has failed to establish a *prima facie* case of obviousness and the claims of Group O are patentable.

#### **4.17. Group P: Claims 44 and 105**

Group P includes Claims **44** and **105**.

Claim **44** depends from Claim **1**. Claim **105** depends from Claim **74**.

Substantial evidence is required of all factual findings, as discussed above.

Absent substantial evidence, no *prima facie* case of obviousness exists.

The rejection of Group P is flawed because the Examiner has not made a *prima facie* case of obviousness:

- the Examiner has consistently ignored the features generally directed to (i) *wherein the primary product is sold by a first retailer*; (ii) *storing in a database information relating to a plurality of available secondary products sold by a second retailer*; and (iii) *determining the package to be offered to the customer comprises accessing the database to select the at least one secondary product from the plurality of available secondary products, the at least one secondary product having a predetermined relationship with the primary product*;
- the Examiner has failed to provide substantial evidence that any such features were known at the time of invention; and
- the Examiner has failed to provide substantial evidence of a motivation to combine or modify the references to provide for such features.

##### **4.17.1. No substantial evidence of the limitations of Group P**

##### **Examiner's Factual Findings**

Although it is not clear, the Examiner may be addressing the features of Group P on page 9 of the Sixth Office Action. The Examiner asserts: "Blinn discloses that [sic] customer may be at interactive kiosks (for example, Col. 6,

lines 9-24).” The Examiner then recites a series of unsupported assertions about kiosks, including:

1. “Kiosks are often found at related retailer stores.”
  2. “While in a merchant’s store at a local shopping center, a customer may use a kiosk to access the system and purchase additional items.”
  3. “A customer may do this possibly to take advantage of discounts that are available on-line and in combination with another merchant’s products.”
- [Sixth Office Action, page 9 (emphasis added)].

#### No Substantial Evidence of the Limitations

The brief mention of “interactive kiosk” in Blinn cannot support the Examiner’s rejection. “Interactive kiosk” is recited as one example of “client 100,” which is described in that portion as a “general purpose computer.” There is no hint in the cited portion, or otherwise in Blinn, that an interactive kiosk would have been understood by one having ordinary skill in the art as necessarily providing for (i) *wherein the primary product is sold by a first retailer*; (ii) *storing in a database information relating to a plurality of available secondary products sold by a second retailer*; and (iii) *determining the package to be offered to the customer comprises accessing the database to select the at least one secondary product from the plurality of available secondary products, the at least one secondary product having a predetermined relationship with the primary product.*

The Examiner apparently recognized this failure of Blinn and attempted to bolster the rejection with the series of unsupported assertions about “kiosks.”

The continuing lack of support for any of those assertions, Appellants’ prompt traversal of those assertions, and Appellants’ argument that the assertions do not constitute substantial evidence, are discussed above. [See, Subject Matter Without Support in the Record]. Subject matter without any evidentiary basis in

the record cannot be used as the basis for a rejection under Section 103. As such, any rejection of Group P based upon the Examiner's assertions as to the alleged functionality of apparatus that allegedly could be "often found at related retailer stores" cannot stand for failure to establish a *prima facie* case.

Appellants further (again) traverse any unsupported assertion by the Examiner that it was known to those of only ordinary skill in the art at the time of the present invention to provide for a "kiosk" to "purchase additional items...possibly to take advantage of discounts that are available on-line and in combination with another merchant's products."

Appellants further (again) traverse any unsupported assertion by the Examiner that it was known to those of only ordinary skill in the art at the time of the present invention to providing for (i) *wherein the primary product is sold by a first retailer*; (ii) *storing in a database information relating to a plurality of available secondary products sold by a second retailer*; and (iii) *determining the package to be offered to the customer comprises accessing the database to select the at least one secondary product from the plurality of available secondary products, the at least one secondary product having a predetermined relationship with the primary product.*

Absent any evidentiary support for the Examiner's assertions of what was "often found" or "well known," at present the record indicates only that the asserted subject matter was

- (i) known to the Examiner (who had the benefit of the present disclosure),
- (ii) at the time the Sixth Office Action was authored.

Further, whether or not the assertions are supported by substantial evidence, nothing in those assertions suggests specifically providing for (i) *wherein the primary product is sold by a first retailer*; (ii) *storing in a database information relating to a plurality of available secondary products sold by a second retailer*;



and (iii) *determining the package to be offered to the customer comprises accessing the database to select the at least one secondary product from the plurality of available secondary products, the at least one secondary product having a predetermined relationship with the primary product.* Neither Blinn or any other prior art of record describes or suggests such a feature. Specifically, in Blinn, although a plurality of retailers may participate in the system, the product that is selected for purchase by a customer and the cross-sell product that may be offered to a customer are sold by the same retailer. There is nothing in the unsupported subject matter remotely suggesting that a package offer may be determined that includes a product sold by a first retailer and a product sold by a second retailer, much less wherein the two products have a predetermined relationship. Accordingly, the Examiner has not even asserted that the explicitly claimed subject matter was known at the time of invention to one of ordinary skill in the art.

To the extent that the Examiner is relying solely upon Blinn, Peirce, or Tice (and/or unsupported assertions) as teaching the additional features recited in Group P, the Section 103(a) rejection cannot stand. The Examiner has failed to indicate any evidence of such features, much less substantial evidence.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness. Neither Blinn, Peirce, nor Tice, alone or in combination, can support any such rejection. The rejection of Group P fails for at least this reason.

**4.17.2. No substantial evidence of a proper motivation to combine or modify the references**

The Examiner has failed to address any additional limitation of Group P or assert that either Blinn, Peirce, or Tice even hint at any additional limitation of Group P. Further, the Examiner simply has not even asserted any motivation to

modify or combine the references to provide for the specific recited features of Group P, much less a motivation supported by the cited references or by substantial evidence of record.

Thus the Examiner has not shown substantial evidence of a motivation in the prior art of record to combine or modify the references in any manner that renders the claims of Group P obvious. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness. The rejection of Group P fails for at least this reason.

#### **4.17.3. Conclusion**

For any one of the above reasons, the Examiner has failed to establish a *prima facie* case of obviousness and the claims of Group P are patentable.

#### **4.18. Group Q: Claims 45 and 106**

Group Q includes Claims **45 and 106**.

The rejection of Group Q is flawed because the Examiner has not made a *prima facie* case of obviousness:

Claim **45** depends from Claims **1 and 44**. Claim **106** depends from Claim **74 and 105**.

Claims **44 and 105** are discussed in Group P. The claims of Group Q are thus allowable for at least the reasons stated with respect to Group P.

Substantial evidence is required of all factual findings, as discussed above. Absent substantial evidence, no *prima facie* case of obviousness exists.

The rejection of Group Q is flawed because the Examiner has not made a *prima facie* case of obviousness:

- the Examiner has consistently ignored the features discussed with respect to Group P;
- the Examiner has consistently ignored the features generally directed to *in response to charging the financial account, authorizing the first retailer to deliver the primary product to the customer and authorizing the second retailer to deliver the at least one secondary product to the customer*;
- the Examiner has failed to provide substantial evidence that any such features were known at the time of invention; and
- the Examiner has failed to provide substantial evidence of a motivation to combine or modify the references to provide for such features.

##### **4.18.1. No substantial evidence of the limitations of Group Q**

##### **Examiner's Factual Findings**

The Examiner has made no factual findings with respect to the additional limitations recited in Claims **45 and 106**.

In fact, the Examiner has not asserted that any of the cited references even hints at any limitation of Claims **45 and 106**.

No Substantial Evidence of the Limitations

The Examiner has not addressed any limitation of Claims **45 and 106**. In fact, the Examiner has not asserted that the cited references even hints at any limitation of Claims **45 and 106**.

Appellants have repeatedly read the cited references and have found no hint that either reference teaches any limitation present in Claims **45 and 106**.

There is no hint in the record of authorizing a retailer to deliver a product, much less authorizing a first retailer to deliver one product of a package and authorizing a second retailer to deliver another product of a package.

Specifically, no reference of record teaches or suggests, alone or in combination, features generally directed to:

1) *receive a customer response indicating an account identifier and an acceptance of the package offer;*

2) *in response to the customer response, authorize a charge to a financial account identified by the account identifier for the amount of the package price; and*

3) *in response to authorizing the charge to the financial account, authorize the first retailer to deliver the primary product to the customer and authorize the second retailer to deliver the at least one secondary product to the customer.*

To the extent that the Examiner is relying solely upon Blinn or Peirce as teaching any feature recited in Claims **45 and 106**, the Section 103(a) rejection

cannot stand. The Examiner has failed to indicate any evidence of such features, much less substantial evidence.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness, and Blinn nor Peirce cannot support any such rejection. The rejection fails for at least this reason.

**4.18.2. No substantial evidence of a proper motivation to combine or modify the references**

The Examiner has failed to address any additional limitation of Group Q or assert that either Blinn, Peirce, or Tice even hint at any additional limitation of Group Q. Further, the Examiner simply has not even asserted any motivation to modify or combine the references to provide for the specific recited features of Group Q, much less a motivation supported by the cited references or by substantial evidence of record.

Thus the Examiner has not shown substantial evidence of a motivation in the prior art of record to combine or modify the references in any manner that renders the claims of Group Q obvious. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness. The rejection of Group Q fails for at least this reason.

**4.18.3. Conclusion**

For any one of the above reasons, the Examiner has failed to establish a *prima facie* case of obviousness and the claims of Group Q are patentable.

#### **4.19. Group R: Claims 46 and 107**

Group R includes Claims **46 and 107**.

*operable to facilitate distribution of an appropriate portion of the charged package price to each of the first retailer and the second retailer*

The rejection of Group R is flawed because the Examiner has not made a *prima facie* case of obviousness:

Claim **45** depends from Claims **1, 44, and 45**. Claim **107** depends from Claim **74, 105, and 106**.

Claims **44 and 105** are discussed in Group P; Claims **45 and 106** are discussed in Group Q. The claims of Group R are thus allowable for at least the reasons stated with respect to Group P and Group Q.

Substantial evidence is required of all factual findings, as discussed above. Absent substantial evidence, no *prima facie* case of obviousness exists.

The rejection of Group R is flawed because the Examiner has not made a *prima facie* case of obviousness:

- the Examiner has consistently ignored the features discussed with respect to Group P and Group Q;
- the Examiner has consistently ignored the features generally directed to *operable to facilitate distribution of an appropriate portion of the charged package price to each of the first retailer and the second retailer*;
- the Examiner has failed to provide substantial evidence that any such features were known at the time of invention; and
- the Examiner has failed to provide substantial evidence of a motivation to combine or modify the references to provide for such features.

#### **4.19.1. No substantial evidence of the limitations of Group R**

##### **Examiner's Factual Findings**

The Examiner has made no factual findings with respect to the additional limitations recited in Claims **46 and 107**.

In fact, the Examiner has not asserted that any of the cited references even hints at any limitation of Claims **46 and 107**.

##### **No Substantial Evidence of the Limitations**

The Examiner has not addressed any limitation of Claims **46 and 107**. In fact, the Examiner has not asserted that the cited references even hints at any limitation of Claims **46 and 107**.

Appellants have repeatedly read the cited references and have found no hint that either reference teaches any limitation present in Claims **46 and 107**.

There is no hint in the record of apportioning a charged package price to a first retailer and a second retailer.

Specifically, no reference of record teaches or suggests, alone or in combination, features generally directed to *facilitating distribution of an appropriate portion of the charged package price to each of the first retailer and the second retailer*.

To the extent that the Examiner is relying solely upon the cited references as teaching any feature recited in Claims **46 and 107**, the Section 103(a) rejection cannot stand. The Examiner has failed to indicate any evidence of such features, much less substantial evidence.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness, and the cited references cannot support any such rejection. The rejection fails for at least this reason.

**4.19.2. No substantial evidence of a proper motivation to combine or modify the references**

The Examiner has failed to address any additional limitation of Group R or assert that either Blinn, Peirce, or Tice even hint at any additional limitation of Group R. Further, the Examiner simply has not even asserted any motivation to modify or combine the references to provide for the specific recited features of Group R, much less a motivation supported by the cited references or by substantial evidence of record.

Thus the Examiner has not shown substantial evidence of a motivation in the prior art of record to combine or modify the references in any manner that renders the claims of Group R obvious. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness. The rejection of Group R fails for at least this reason.

**4.19.3. Conclusion**

For any one of the above reasons, the Examiner has failed to establish a *prima facie* case of obviousness and the claims of Group R are patentable.



#### **4.20. Group S: Claim 56**

Group S includes Claim 56.

Claim 56 depends from Claims 47, 54, and 55.

Substantial evidence is required of all factual findings, as discussed above.

Absent substantial evidence, no *prima facie* case of obviousness exists.

The rejection of Group S is flawed because the Examiner has not made a *prima facie* case of obviousness:

- the Examiner has failed to provide substantial evidence that the following features were known at the time of invention: (i) *receiving a code from the retailer*; (ii) *upon visiting the retail establishment, presenting the code to the retailer*; and (iii) *whereby the retailer may use the code to verify that the financial account has been charged in the amount of the package price*; and
- the Examiner has failed to provide substantial evidence of a motivation to combine or modify the references to provide for such features.

##### **4.20.1. No substantial evidence of the limitations of Group S**

###### **Examiner's Factual Findings**

The Examiner asserts: "Blinn discloses that [sic] customer may be at interactive kiosks (for example, Col. 6, lines 9-24)." The Examiner then recites the following unsupported assertions about kiosks:

1. "Kiosks are often found at related retailer stores."
2. "While in a merchant's store at a local shopping center, a customer may use a kiosk to access the system and purchase additional items."
3. "A customer may do this possibly to take advantage of discounts that are available on-line and in combination with another merchant's products."
4. "Using a mall or a store's kiosk, a customer may"

- (a) “order items,”
  - (b) “pay for them and”
  - (c) “obtain a printed copy of a coded receipt.”
5. “The customer may present coded receipts to merchants who may”
- (a) “verify payment of the package order, and”
  - (b) “deliver the items.”

[Sixth Office Action, page 9 (emphasis added)].

Although Appellants are not certain, the emphasized portions may have been intended as the basis for the rejection of Group S.

#### No Substantial Evidence of the Limitations

The Examiner has not provided substantial evidence of the above-mentioned features of Group S.

The brief mention of “interactive kiosk” in Blinn cannot support the Examiner’s rejection. “Interactive kiosk” is recited as one example of “client 100,” which is described in that portion as a “general purpose computer.” There is no hint in the cited portion, or otherwise in Blinn, that an interactive kiosk would have been understood by one having ordinary skill in the art as necessarily providing for (i) *receiving a code from the retailer*; (ii) *upon visiting the retail establishment, presenting the code to the retailer*; and (iii) *whereby the retailer may use the code to verify that the financial account has been charged in the amount of the package price*.

The Examiner apparently recognized this failure of Blinn and attempted to bolster the rejection with the series of unsupported assertions about “kiosks” and merchants “who may verify payment of the package order” based on “coded receipts” obtained from a “kiosk” and presented by a customer.

The continuing lack of support for any of those assertions, Appellants' prompt traversal of those assertions, and Appellants' argument that the assertions do not constitute substantial evidence, are discussed above. [See, Subject Matter Without Support in the Record]. Subject matter without any evidentiary basis in the record cannot be used as the basis for a rejection under Section 103. As such, any rejection of Group S based upon the Examiner's assertions as to the alleged practices of merchants and the alleged functionality of apparatus that allegedly could be "often found at related retailer stores," cannot stand for failure to establish a *prima facie* case.

Appellants further (again) traverse any unsupported assertion by the Examiner that it was known to those of only ordinary skill in the art at the time of the present invention to produce, "at related retailer stores," "a printed copy of a coded receipt" that could be presented to a merchant "who may verify payment of the package order, and deliver the items."

Appellants further (again) traverse any unsupported assertion by the Examiner that it was known to those of only ordinary skill in the art at the time of the present invention to receive *from a retailer, a code that upon visiting the retail establishment, may be present to the retailer whereby the retailer may use the code to verify that the financial account has been charged in the amount of the package price.*

Absent any evidentiary support for the Examiner's assertions of what was "often found" or "well known," at present the record indicates only that the asserted subject matter was

- (i) known to the Examiner (who had the benefit of the present disclosure),
- (ii) at the time the Sixth Office Action was authored.

Further, whether or not the assertions are supported by substantial evidence, nothing in those assertions suggests specifically (i) *receiving a code from the*

*retailer; (ii) upon visiting the retail establishment, presenting the code to the retailer; and (iii) whereby the retailer may use the code to verify that the financial account has been charged in the amount of the package price.* Accordingly, the Examiner has not even asserted that the explicitly claimed subject matter was known at the time of invention to one of ordinary skill in the art.

To the extent that the Examiner is relying solely upon Blinn, Peirce, or Tice (and/or unsupported assertions) as teaching the additional features recited in Group S, the Section 103(a) rejection cannot stand. The Examiner has failed to indicate any evidence of such features, much less substantial evidence.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness. Neither Blinn, Peirce, nor Tice, alone or in combination, can support any such rejection. The rejection of Group S fails for at least this reason.

**4.20.2. No substantial evidence of a proper motivation to combine or modify the references**

The Examiner has failed to establish substantial evidence of the features of Group S.

Similarly, the Examiner has failed to provide any evidence in support of a motivation to modify any combination of the cited references to provide for the “kiosks” described in the Examiner’s unsupported assertions.

As the record is devoid of any support for either what the Examiner asserts was “often found at related retailer stores,” the Examiner simply has not provided substantial evidence of any motivation to modify or combine the references to provide for either the asserted subject matter or the specific recited features of Group S. Further, as discussed above, even if a motivation to provide for the asserted subject matter had been properly supported, the modification would not have provided specifically for the claimed subject matter.

Thus the Examiner has not shown substantial evidence of a motivation in the prior art of record to combine or modify the references in any manner that renders the claims of Group S obvious. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness. The rejection of Group S fails for at least this reason.

#### **4.20.3. Conclusion**

For any one of the above reasons, the Examiner has failed to establish a *prima facie* case of obviousness and the claims of Group S are patentable.

#### **4.21. Group T: Claims 67, 102, and 104**

Group T includes Claims 67, 102, and 104.

Substantial evidence is required of all factual findings, as discussed above. Absent substantial evidence, no *prima facie* case of obviousness exists.

The rejection of Group T is flawed because the Examiner has not made a *prima facie* case of obviousness:

- the Examiner has failed to provide substantial evidence that the following features were known at the time of invention: (i) *wherein the point of sale terminal communicates with a central server to determine the package price;* and (ii) *wherein the point of sale terminal communicates with a financial institution to charge the package price to the financial account;* and
- the Examiner has failed to provide substantial evidence of a motivation to combine or modify the references to provide for such features.

##### **4.21.1. No substantial evidence of the limitations of Group T**

###### **Examiner's Factual Findings**

The Examiner asserts: "Blinn discloses that [sic] customer may be at interactive kiosks (for example, Col. 6, lines 9-24)." The Examiner then recites the following unsupported assertions about kiosks:

1. "Kiosks are often found at related retailer stores."
2. "While in a merchant's store at a local shopping center, a customer may use a kiosk to access the system and purchase additional items."
3. "A customer may do this possibly to take advantage of discounts that are available on-line and in combination with another merchant's products."
4. "Using a mall or a store's kiosk, a customer may"
  - (a) "order items,"

- (b) “pay for them and”
- (c) “obtain a printed copy of a coded receipt.”
- 5. “The customer may present coded receipts to merchants who may”
  - (a) “verify payment of the package order, and”
  - (b) “deliver the items.”

[Sixth Office Action, page 9 (emphasis added)].

Although Appellants are not certain, the emphasized portions may have been intended as the basis for the rejection of Group T.

The Examiner admits that ‘Blinn *does not* use the term bar code or Point of Sale Terminal. While Blinn discloses the use of a printed copy and online checkout receipt, Blinn *does not* specifically state that a printed receipt may include information in bar code formats.’ Presumably as a result of the Examiner’s inability or unwillingness to identify such subject matter in the prior art of record, the Examiner resorts to taking “official notice that [(i)] bar codes and Point of Sales [sic] terminals are well known to one of ordinary skill in the art, and that [(ii)] printed receipts and coupons often contain bar-coded information. [(iii)] Such information may include store or item specific information such as store id, item id, receipt or transaction information.’ [Sixth Office Action, page 10 (notation added)].

Although Appellants are not certain, the emphasized portions may have been intended as the basis for the rejection of Group T.

#### No Substantial Evidence of the Limitations

The Examiner has not provided substantial evidence of the above-mentioned features of Group T.

The brief mention of “interactive kiosk” in Blinn cannot support the Examiner’s rejection. “Interactive kiosk” is recited as one example of “client

100,” which is described in that portion as a “general purpose computer.” There is no hint in the cited portion, or otherwise in Blinn, that an interactive kiosk would have been understood by one having ordinary skill in the art as necessarily providing for (i) *wherein the point of sale terminal communicates with a central server to determine the package price*; and (ii) *wherein the point of sale terminal communicates with a financial institution to charge the package price to the financial account*.

The Examiner apparently recognized this failure of Blinn and attempted to bolster the rejection with the series of unsupported assertions about “kiosks” and “Point of Sales terminals.”

The continuing lack of support for any of those assertions, Appellants’ prompt traversal of those assertions, and Appellants’ argument that the assertions do not constitute substantial evidence, are discussed above. [See, Subject Matter Without Support in the Record]. Subject matter without any evidentiary basis in the record cannot be used as the basis for a rejection under Section 103. As such, any rejection of Group T based upon the Examiner’s assertions as to what was “well known” or the alleged functionality of apparatus that allegedly could be “often found at related retailer stores,” cannot stand for failure to establish a *prima facie* case.

Appellants further traverse any unsupported assertion by the Examiner that it was known to those of only ordinary skill in the art at the time of the present invention to provide for (i) *wherein the point of sale terminal communicates with a central server to determine the package price*; and (ii) *wherein the point of sale terminal communicates with a financial institution to charge the package price to the financial account*.



Absent any evidentiary support for the Examiner's assertions of what was "often found" or "well known," at present the record indicates only that the asserted subject matter was

- (i) known to the Examiner (who had the benefit of the present disclosure),
- (ii) at the time the Sixth Office Action was authored.

Further, whether or not the assertions are supported by substantial evidence, nothing in those assertions suggests specifically (i) *wherein the point of sale terminal communicates with a central server to determine the package price*; and (ii) *wherein the point of sale terminal communicates with a financial institution to charge the package price to the financial account*. Accordingly, the Examiner has not even asserted that the explicitly claimed subject matter was known at the time of invention to one of ordinary skill in the art.

To the extent that the Examiner is relying solely upon Blinn, Peirce, or Tice (and/or unsupported assertions) as teaching the additional features recited in Group T, the Section 103(a) rejection cannot stand. The Examiner has failed to indicate any evidence of such features, much less substantial evidence.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness. Neither Blinn, Peirce, nor Tice, alone or in combination, can support any such rejection. The rejection of Group T fails for at least this reason.

**4.21.2. No substantial evidence of a proper motivation to combine or modify the references**

The Examiner has failed to establish substantial evidence of the features of Group T.

Similarly, the Examiner has failed to provide any evidence in support of a motivation to modify any combination of the cited references to provide for the

“kiosks” or “Point of Sales terminals” described in the Examiner’s unsupported assertions.

As the record is devoid of any support for either what the Examiner asserts was “often found at related retailer stores” or “well known,” the Examiner simply has not provided substantial evidence of any motivation to modify or combine the references to provide for either the asserted subject matter or the specific recited features of Group T. Further, as discussed above, even if a motivation to provide for the asserted subject matter had been properly supported, the modification would not have provided specifically for the claimed subject matter.

Thus the Examiner has not shown substantial evidence of a motivation in the prior art of record to combine or modify the references in any manner that renders the claims of Group T obvious. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness. The rejection of Group T fails for at least this reason.

#### **4.21.3. Conclusion**

For any one of the above reasons, the Examiner has failed to establish a *prima facie* case of obviousness and the claims of Group T are patentable.

#### **4.22. Group U: Claims 70 and 72**

Group U includes Claims **70 and 72**.

The rejection of Group U is flawed because the Examiner has not made a *prima facie* case of obviousness:

Claims **70 and 72** depend from Claims **44 and 69**.

Substantial evidence is required of all factual findings, as discussed above. Absent substantial evidence, no *prima facie* case of obviousness exists.

The rejection of Group U is flawed because the Examiner has not made a *prima facie* case of obviousness:

- the Examiner has consistently ignored the features generally directed to *obtaining the primary product and the at least one secondary product from the plurality of different retailers*, by either (i) *visiting each of the plurality of different retailers to pick up the primary product and the at least one secondary products*, or (ii) *receiving a plurality of shipments containing the primary product and the at least one secondary product*;
- the Examiner has failed to provide substantial evidence that any such features were known at the time of invention; and
- the Examiner has failed to provide substantial evidence of a motivation to combine or modify the references to provide for such features.

##### **4.22.1. No substantial evidence of the limitations of Group U**

###### **Examiner's Factual Findings**

The Examiner has made no factual findings with respect to the additional limitations recited in Claims **70 and 72**.

In fact, the Examiner has not asserted that any of the cited references even hints at any limitation of Claims **70 and 72**.

### No Substantial Evidence of the Limitations

The Examiner has not addressed any limitation of Claims **70 and 72**. In fact, the Examiner has not asserted that the cited references even hints at any limitation of Claims **70 and 72**.

Appellants have repeatedly read the cited references and have found no hint that either reference teaches any limitation present in Claims **70 and 72**.

There is no hint in the record of obtaining products of a package from a plurality of sources, much less visiting each of a plurality of retailers or receiving a plurality of shipments.

Specifically, no reference of record teaches or suggests, alone or in combination, features generally directed to:

*obtaining the primary product and the at least one secondary product from the plurality of different retailers, by either (i) visiting each of the plurality of different retailers to pick up the primary product and the at least one secondary products, or (ii) receiving a plurality of shipments containing the primary product and the at least one secondary product.*

To the extent that the Examiner is relying solely upon the cited references as teaching any feature recited in Claims **70 and 72**, the Section 103(a) rejection cannot stand. The Examiner has failed to indicate any evidence of such features, much less substantial evidence.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness, and the cited references cannot support any such rejection. The rejection fails for at least this reason.

**4.22.2. No substantial evidence of a proper motivation to combine or modify the references**

The Examiner has failed to address any additional limitation of Group U or assert that either Blinn, Peirce, or Tice even hint at any additional limitation of Group U. Further, the Examiner simply has not even asserted any motivation to modify or combine the references to provide for the specific recited features of Group U, much less a motivation supported by the cited references or by substantial evidence of record.

Thus the Examiner has not shown substantial evidence of a motivation in the prior art of record to combine or modify the references in any manner that renders the claims of Group U obvious. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness. The rejection of Group U fails for at least this reason.

**4.22.3. Conclusion**

For any one of the above reasons, the Examiner has failed to establish a *prima facie* case of obviousness and the claims of Group U are patentable.

#### **4.23. Group V: Claim 71**

Group V includes Claim 71.

Claim 71 depends from Claims 47, 69, and 70.

Claim 70 is discussed in Group U. Group V is thus allowable for at least the reasons stated with respect to Group U.

Substantial evidence is required of all factual findings, as discussed above. Absent substantial evidence, no *prima facie* case of obviousness exists.

The rejection of Group V is flawed because the Examiner has not made a *prima facie* case of obviousness:

- the Examiner has consistently ignored the features discussed with respect to Group U;
- the Examiner has failed to provide substantial evidence that the following features were known at the time of invention: (i) *receiving a code in response to providing the customer response*; (ii) *upon visiting the plurality of different retailers, presenting the code to each of the plurality of different retailers*; and (iii) *whereby each of the plurality of different retailers may use the code to verify that the financial account has been charged in the amount of the package price*; and
- the Examiner has failed to provide substantial evidence of a motivation to combine or modify the references to provide for such features.

##### **4.23.1. No substantial evidence of the limitations of Group V**

##### **Examiner's Factual Findings**

The Examiner asserts: “Blinn discloses that [sic] customer may be at interactive kiosks (for example, Col. 6, lines 9-24).” The Examiner then recites the following unsupported assertions about kiosks:

1. “Kiosks are often found at related retailer stores.”
2. “While in a merchant’s store at a local shopping center, a customer may use a kiosk to access the system and purchase additional items.”
3. “A customer may do this possibly to take advantage of discounts that are available on-line and in combination with another merchant’s products.”
4. “Using a mall or a store’s kiosk, a customer may”
  - (a) “order items,”
  - (b) “pay for them and”
  - (c) “obtain a printed copy of a coded receipt.”
5. “The customer may present coded receipts to merchants who may”
  - (a) “verify payment of the package order, and”
  - (b) “deliver the items.”

[Sixth Office Action, page 9 (emphasis added)].

Although Appellants are not certain, the emphasized portions may have been intended as the basis for the rejection of Group V.

#### No Substantial Evidence of the Limitations

The Examiner has not provided substantial evidence of the above-mentioned features of Group V.

The brief mention of “interactive kiosk” in Blinn cannot support the Examiner’s rejection. “Interactive kiosk” is recited as one example of “client 100,” which is described in that portion as a “general purpose computer.” There is no hint in the cited portion, or otherwise in Blinn, that an interactive kiosk would have been understood by one having ordinary skill in the art as necessarily providing for (i) *receiving a code in response to providing the customer response*; (ii) *upon visiting the plurality of different retailers, presenting the code to each of the plurality of different retailers*; and (iii) *whereby each of the plurality of*

*different retailers may use the code to verify that the financial account has been charged in the amount of the package price.*

The Examiner apparently recognized this failure of Blinn and attempted to bolster the rejection with the series of unsupported assertions about “kiosks” and merchants “who may verify payment of the package order” based on “coded receipts” obtained from a “kiosk” and presented by a customer.

The continuing lack of support for any of those assertions, Appellants’ prompt traversal of those assertions, and Appellants’ argument that the assertions do not constitute substantial evidence, are discussed above. [See, Subject Matter Without Support in the Record]. Subject matter without any evidentiary basis in the record cannot be used as the basis for a rejection under Section 103. As such, any rejection of Group V based upon the Examiner’s assertions as to the alleged practices of merchants and the alleged functionality of apparatus that allegedly could be “often found at related retailer stores,” cannot stand for failure to establish a *prima facie* case.

Appellants further (again) traverse any unsupported assertion by the Examiner that it was known to those of only ordinary skill in the art at the time of the present invention to produce, “at related retailer stores,” “a printed copy of a coded receipt” that could be presented to a merchant “who may verify payment of the package order, and deliver the items.”

Appellants further (again) traverse any unsupported assertion by the Examiner that it was known to those of only ordinary skill in the art at the time of the present invention to receive *a code that upon visiting one retailer, may be presented to the retailer whereby the retailer may use the code to verify that the financial account has been charged in the amount of the package price*, much less that it was known to present such a code to each of a plurality of retailers upon visiting each retailer.



Absent any evidentiary support for the Examiner's assertions of what was "often found" or "well known," at present the record indicates only that the asserted subject matter was

- (i) known to the Examiner (who had the benefit of the present disclosure),
- (ii) at the time the Sixth Office Action was authored.

Further, whether or not the assertions are supported by substantial evidence, nothing in those assertions suggests specifically (i) *receiving a code in response to providing the customer response*; (ii) *upon visiting the plurality of different retailers, presenting the code to each of the plurality of different retailers*; and (iii) *whereby each of the plurality of different retailers may use the code to verify that the financial account has been charged in the amount of the package price*.

Accordingly, the Examiner has not even asserted that the explicitly claimed subject matter was known at the time of invention to one of ordinary skill in the art.

To the extent that the Examiner is relying solely upon Blinn, Peirce, or Tice (and/or unsupported assertions) as teaching the additional features recited in Group V, the Section 103(a) rejection cannot stand. The Examiner has failed to indicate any evidence of such features, much less substantial evidence.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness. Neither Blinn, Peirce, nor Tice, alone or in combination, can support any such rejection. The rejection of Group V fails for at least this reason.

**4.23.2. No substantial evidence of a proper motivation to combine or modify the references**

The Examiner has failed to establish substantial evidence of the features of Group V.

Similarly, the Examiner has failed to provide any evidence in support of a motivation to modify any combination of the cited references to provide for the “kiosks” described in the Examiner’s unsupported assertions.

As the record is devoid of any support for either what the Examiner asserts was “often found at related retailer stores,” the Examiner simply has not provided substantial evidence of any motivation to modify or combine the references to provide for either the asserted subject matter or the specific recited features of Group V. Further, as discussed above, even if a motivation to provide for the asserted subject matter had been properly supported, the modification would not have provided specifically for the claimed subject matter.

Thus the Examiner has not shown substantial evidence of a motivation in the prior art of record to combine or modify the references in any manner that renders the claims of Group V obvious. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness. The rejection of Group V fails for at least this reason.

#### **4.23.3. Conclusion**

For any one of the above reasons, the Examiner has failed to establish a *prima facie* case of obviousness and the claims of Group V are patentable.

#### **4.24. Group W: Claim 103**

Group W includes Claim 71.

Claim 103 depends from Claim 102.

Claim 103 is discussed in Group T. Group W is thus allowable for at least the reasons stated with respect to Group T.

Substantial evidence is required of all factual findings, as discussed above. Absent substantial evidence, no *prima facie* case of obviousness exists.

The rejection of Group W is flawed because the Examiner has not made a *prima facie* case of obviousness:

- the Examiner has consistently ignored the features discussed with respect to Group T;
- the Examiner has failed to provide substantial evidence that the following features were known at the time of invention: *wherein the customer response further indicates a code identifying the package offer and product identifiers for the primary product and the at least one secondary product included in the package*; and
- the Examiner has failed to provide substantial evidence of a motivation to combine or modify the references to provide for such features.

##### **4.24.1. No substantial evidence of the limitations of Group W**

###### **Examiner's Factual Findings**

The Examiner asserts: "Blinn discloses that [sic] customer may be at interactive kiosks (for example, Col. 6, lines 9-24)." The Examiner then recites the following unsupported assertions about kiosks:

1. "Kiosks are often found at related retailer stores."

2. “While in a merchant’s store at a local shopping center, a customer may use a kiosk to access the system and purchase additional items.”
3. “A customer may do this possibly to take advantage of discounts that are available on-line and in combination with another merchant’s products.”
4. “Using a mall or a store’s kiosk, a customer may”
  - (a) “order items,”
  - (b) “pay for them and”
  - (c) “obtain a printed copy of a coded receipt.”
5. “The customer may present coded receipts to merchants who may”
  - (a) “verify payment of the package order, and”
  - (b) “deliver the items.”

[Sixth Office Action, page 9].

The Examiner admits that ‘Blinn *does not* use the term bar code or Point of Sale Terminal. While Blinn discloses the use of a printed copy and online checkout receipt, Blinn *does not* specifically state that a printed receipt may include information in bar code formats.’ Presumably as a result of the Examiner’s inability or unwillingness to identify such subject matter in the prior art of record, the Examiner resorts to taking “official notice that [(i)] bar codes and Point of Sales [sic] terminals are well known to one of ordinary skill in the art, and that [(ii)] printed receipts and coupons often contain bar-coded information. [(iii)] Such information may include store or item specific information such as store id, item id, receipt or transaction information.’ [Sixth Office Action, page 10 (notation added)].

#### No Substantial Evidence of the Limitations

The Examiner has not provided substantial evidence of the above-mentioned features of Group W.

The brief mention of “interactive kiosk” in Blinn cannot support the Examiner’s rejection. “Interactive kiosk” is recited as one example of “client 100,” which is described in that portion as a “general purpose computer.” There is no hint in the cited portion, or otherwise in Blinn, that an interactive kiosk would have been understood by one having ordinary skill in the art as necessarily providing for *a code identifying (i) the package offer and (ii) product identifiers for (a) the primary product and (b) the at least one secondary product included in the package.*

The Examiner apparently recognized this failure of Blinn and attempted to bolster the rejection with the series of unsupported assertions about “kiosks” and “bar codes and Point of Sales terminals.”

The continuing lack of support for any of those assertions, Appellants’ prompt traversal of those assertions, and Appellants’ argument that the assertions do not constitute substantial evidence, are discussed above. [See, Subject Matter Without Support in the Record]. Subject matter without any evidentiary basis in the record cannot be used as the basis for a rejection under Section 103. As such, any rejection of Group W based upon the Examiner’s assertions as to the alleged functionality of apparatus that allegedly could be “often found at related retailer stores” cannot stand for failure to establish a *prima facie* case.

Appellants further (again) traverse any unsupported assertion by the Examiner that it was known to those of only ordinary skill in the art at the time of the present invention to produce, “at related retailer stores,” “a printed copy of a coded receipt” that could be presented to a merchant “who may verify payment of the package order, and deliver the items.”

Appellants further (again) traverse any unsupported assertion by the Examiner that it was known to those of only ordinary skill in the art at the time of the present invention to provide *a code identifying (i) the package offer and (ii)*

*product identifiers for (a) the primary product and (b) the at least one secondary product included in the package.*

Absent any evidentiary support for the Examiner's assertions of what was "often found" or "well known," at present the record indicates only that the asserted subject matter was

- (i) known to the Examiner (who had the benefit of the present disclosure),
- (ii) at the time the Sixth Office Action was authored.

Further, whether or not the assertions are supported by substantial evidence, nothing in those assertions suggests specifically *a code identifying (i) the package offer and (ii) product identifiers for (a) the primary product and (b) the at least one secondary product included in the package.* Accordingly, the Examiner has not even asserted that the explicitly claimed subject matter was known at the time of invention to one of ordinary skill in the art.

To the extent that the Examiner is relying solely upon Blinn, Peirce, or Tice (and/or unsupported assertions) as teaching the additional features recited in Group W, the Section 103(a) rejection cannot stand. The Examiner has failed to indicate any evidence of such features, much less substantial evidence.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness. Neither Blinn, Peirce, nor Tice, alone or in combination, can support any such rejection. The rejection of Group W fails for at least this reason.

**4.24.2. No substantial evidence of a proper motivation to combine or modify the references**

The Examiner has failed to establish substantial evidence of the features of Group W.

Similarly, the Examiner has failed to provide any evidence in support of a motivation to modify any combination of the cited references to provide for either

the “kiosks” or the “bar codes and Point of Sales terminals” described in the Examiner’s unsupported assertions.

The Examiner’s states only that there is an allegedly “obvious reason” to provide for the asserted subject matter: “bar codes make it possible to read information directly into a computer and to transact business in a more efficient manner, including at least avoidance of human error and illegible handwriting.” [Sixth Office Action, page 10].

As the record is devoid of any support for either what the Examiner asserts was “well known” or what allegedly is an “obvious reason” to use bar codes, the Examiner simply has not provided substantial evidence of any motivation to modify or combine the references to provide for either the asserted subject matter or the specific recited features of Group W. Further, as discussed above, even if a motivation to provide for the asserted subject matter had been properly supported, the modification would not have provided specifically for the claimed subject matter.

Thus the Examiner has not shown substantial evidence of a motivation in the prior art of record to combine or modify the references in any manner that renders the claims of Group W obvious. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness. The rejection of Group W fails for at least this reason.

#### **4.24.3. Conclusion**

For any one of the above reasons, the Examiner has failed to establish a *prima facie* case of obviousness and the claims of Group W are patentable.

#### **4.25. Group X: Claim 114**

Group X includes Claim 114.

Claim 114 depends from Claims 108 and 109.

Substantial evidence is required of all factual findings, as discussed above. Absent substantial evidence, no *prima facie* case of obviousness exists.

The rejection of Group X is flawed because the Examiner has not made a *prima facie* case of obviousness:

- the Examiner has failed to provide substantial evidence that the following features were known at the time of invention: (i) *wherein the processor is further operable to receive a code via the communications port in response to sending the customer response*; and (ii) *whereby the code may be presented to a retailer for verification that the financial account has been charged in the amount of the package price*; and
- the Examiner has failed to provide substantial evidence of a motivation to combine or modify the references to provide for such features.

##### **4.25.1. No substantial evidence of the limitations of Group X**

###### **Examiner's Factual Findings**

The Examiner asserts: "Blinn discloses that [sic] customer may be at interactive kiosks (for example, Col. 6, lines 9-24)." The Examiner then recites the following unsupported assertions about kiosks:

1. "Kiosks are often found at related retailer stores."
2. "While in a merchant's store at a local shopping center, a customer may use a kiosk to access the system and purchase additional items."
3. "A customer may do this possibly to take advantage of discounts that are available on-line and in combination with another merchant's products."



4. “Using a mall or a store’s kiosk, a customer may”
  - (a) “order items,”
  - (b) “pay for them and”
  - (c) “obtain a printed copy of a coded receipt.”
5. “The customer may present coded receipts to merchants who may”
  - (a) “verify payment of the package order, and”
  - (b) “deliver the items.”

[Sixth Office Action, page 9 (emphasis added)].

Although Appellants are not certain, the emphasized portions may have been intended as the basis for the rejection of Group X.

#### No Substantial Evidence of the Limitations

The Examiner has not provided substantial evidence of the above-mentioned features of Group X.

The brief mention of “interactive kiosk” in Blinn cannot support the Examiner’s rejection. “Interactive kiosk” is recited as one example of “client 100,” which is described in that portion as a “general purpose computer.” There is no hint in the cited portion, or otherwise in Blinn, that an interactive kiosk would have been understood by one having ordinary skill in the art as necessarily providing (i) *wherein the processor is further operable to receive a code via the communications port in response to sending the customer response*; and (ii) *whereby the code may be presented to a retailer for verification that the financial account has been charged in the amount of the package price*.

The Examiner apparently recognized this failure of Blinn and attempted to bolster the rejection with the series of unsupported assertions about “kiosks” and merchants “who may verify payment of the package order” based on “coded receipts” obtained from a “kiosk” and presented by a customer.

The continuing lack of support for any of those assertions, Appellants' prompt traversal of those assertions, and Appellants' argument that the assertions do not constitute substantial evidence, are discussed above. [See, Subject Matter Without Support in the Record]. Subject matter without any evidentiary basis in the record cannot be used as the basis for a rejection under Section 103. As such, any rejection of Group X based upon the Examiner's assertions as to the alleged practices of merchants and the alleged functionality of apparatus that allegedly could be "often found at related retailer stores," cannot stand for failure to establish a *prima facie* case.

Appellants further (again) traverse any unsupported assertion by the Examiner that it was known to those of only ordinary skill in the art at the time of the present invention to produce, "at related retailer stores," "a printed copy of a coded receipt" that could be presented to a merchant "who may verify payment of the package order, and deliver the items."

Appellants further (again) traverse any unsupported assertion by the Examiner that it was known to those of only ordinary skill in the art at the time of the present invention to receive *via communications port in response to sending the consumer response, a code that may be presented to a retailer for verification that the financial account has been charged in the amount of the package price.*

Absent any evidentiary support for the Examiner's assertions of what was "often found" or "well known," at present the record indicates only that the asserted subject matter was

- (i) known to the Examiner (who had the benefit of the present disclosure),
- (ii) at the time the Sixth Office Action was authored.

Further, whether or not the assertions are supported by substantial evidence, nothing in those assertions suggests specifically (i) *wherein the processor is further operable to receive a code via the communications port in response to sending the*

*customer response; and (ii) whereby the code may be presented to a retailer for verification that the financial account has been charged in the amount of the package price.* Accordingly, the Examiner has not even asserted that the explicitly claimed subject matter was known at the time of invention to one of ordinary skill in the art.

To the extent that the Examiner is relying solely upon Blinn, Peirce, or Tice (and/or unsupported assertions) as teaching the additional features recited in Group X, the Section 103(a) rejection cannot stand. The Examiner has failed to indicate any evidence of such features, much less substantial evidence.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness. Neither Blinn, Peirce, nor Tice, alone or in combination, can support any such rejection. The rejection of Group X fails for at least this reason.

**4.25.2. No substantial evidence of a proper motivation to combine or modify the references**

The Examiner has failed to establish substantial evidence of the features of Group X.

Similarly, the Examiner has failed to provide any evidence in support of a motivation to modify any combination of the cited references to provide for the “kiosks” described in the Examiner’s unsupported assertions.

As the record is devoid of any support for either what the Examiner asserts was “often found at related retailer stores,” the Examiner simply has not provided substantial evidence of any motivation to modify or combine the references to provide for either the asserted subject matter or the specific recited features of Group X. Further, as discussed above, even if a motivation to provide for the asserted subject matter had been properly supported, the modification would not have provided specifically for the claimed subject matter.

Thus the Examiner has not shown substantial evidence of a motivation in the prior art of record to combine or modify the references in any manner that renders the claims of Group X obvious. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness. The rejection of Group X fails for at least this reason.

#### **4.25.3. Conclusion**

For any one of the above reasons, the Examiner has failed to establish a *prima facie* case of obviousness and the claims of Group X are patentable.

**5. Section 103(a) Rejection—Blinn + Bernard**

Claims **119-126** stand rejected as obvious under 35 U.S.C. § 103(a) in light of Blinn and Bernard.

The Examiner's Section 103(a) rejections based on the above grounds are argued separately for the following Groups of appealed claims:

Group Y.	Claims 119, 123, 124, 125, and 126
Group Z.	Claim 120
Group AA.	Claim 121
Group BB.	Claim 122

The claims in different groups do not stand and fall together. Each of the Groups is addressed below under a separate heading.

The applicable law for review of obviousness rejections is discussed above.

### **5.1. Group Y: Claims 119, 123, 124, 125, and 126**

Group Y includes independent Claims 119, 123, 124, 125 and 126.

Substantial evidence is required of all factual findings, as discussed above.

Absent substantial evidence, no *prima facie* case of obviousness exists.

The rejection of Group Y is flawed because the Examiner has not made a *prima facie* case of obviousness:

- the Examiner has failed to provide substantial evidence that the following features were known at the time of invention:
  - (i) *in response to detecting the loss of interest in the primary product,*
  - (ii) *determining a package to be offered to the customer,*
  - (iii) *the package comprising the primary product and at least one secondary product,*
  - (iv) *the primary product and the at least one secondary product each having a corresponding retail price; and*
- the Examiner has failed to provide substantial evidence of a motivation to combine or modify the references to provide for such features.

#### **5.1.1. No substantial evidence of the limitations of Group Y**

##### **Examiner's Factual Findings**

The Examiner admits that “Blinn does not provide specific example of selecting secondary products based on an indication of interest by a customer in the secondary product.” [Sixth Office Action, page 12].

The Examiner asserts that “Bernard discloses detecting a loss of interest in a primary product by a customer, by tracking events such as when a customer removes items from a shopping card [sic]. See, for example, Col. 33, lines 4-63.” [Sixth Office Action, page 12].

### No Substantial Evidence of the Limitations

The cited portion of Bernard states: “VRU 104 may prompt the caller to either put the selections which are on hold back into the virtual shopping cart or to delete the selection from the list of items on hold.” Column 33, lines 13-16.

Bernard thus possibly might have suggested, to one of ordinary skill in the art, identifying a selection that is “on hold,” and somehow prompting caller to either place the selection back into a virtual shopping cart or to delete the selection.

Contrary to the Examiner’s assertion, however, nothing in the cited portion or otherwise in Bernard teaches or suggests “tracking” events such as a customer removing an item from a shopping cart. At best, there is a suggestion of a list of items “on hold.” There is no suggestion that deletion of an item “on hold” is a “tracked” event, whatever that means to the Examiner.

Further, Bernard does not suggest *determining a package to be offered to the customer in response to detecting the loss of interest in the primary product*. There is no suggestion of doing anything in response to having items “on hold” other than the explicitly described prompt to the caller, much less determining a package of any kind to offer a customer.

As described in the very portion of Bernard cited by the Examiner, a caller is given a choice only between deleting an item from an “on hold” list or putting it back in a shopping cart. Nothing in Bernard suggests doing anything else with an item a caller wants “discarded”—except deleting it from the “on hold” list, of course.

Effectively, the Examiner has inappropriately attempted (and failed) to demonstrate that individual elements of the limitation are present in Bernard and fails to address the limitation in its entirety.

Appellants have repeatedly read both Blinn and Bernard, and have found no hint that either reference teaches any limitation present in Claims **119, 123, 124, 125, and 126**.

To the extent that the Examiner is relying solely upon Blinn or Bernard as teaching any feature recited in Claims **119, 123, 124, 125, and 126**, the Section 103(a) rejection cannot stand. The Examiner has failed to indicate any evidence of such features, much less substantial evidence.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness, and Blinn nor Bernard cannot support any such rejection. The rejection fails for at least this reason.

**5.1.2. No showing of a proper motivation to combine the references**

The Examiner rejected the claims of Group Y, Claims **119, 123, 124, 125, and 126**, as unpatentable over Blinn in view of Bernard.

The Examiner asserts that

it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Blinn and Bernard to disclose that, in response to detecting a loss of interest in an item, one may offer a customer a package comprising the “discarded” primary item and an additional item for a price that is less than the sum of the corresponding retail prices of the primary and additional items.

[Sixth Office Action, page 13].

As a motivation for the above combination, the Examiner states that one would have been motivated to combine Blinn and Bernard

for the obvious reason that merchants often wish to provide maximum flexibility to a customer by permitting a customer to review the items in a shopping basket and may offer package or discounts on removed items to prevent customers from walking out and possibly buying the same primary item at a competitor.



[Sixth Office Action, page 13].

No evidence, much less substantial evidence, is offered in support of this asserted “obvious” motivation. The references cannot support the motivation. Accordingly, it cannot support a *prima facie* case of obviousness of Group Y.

Neither Bernard nor Blinn suggests the hypothetical “offer a customer a package comprising the “discarded” primary item and an additional item” or the hypothetical “obvious reason” proposed by the Examiner. As described in the very portion of Bernard cited by the Examiner, a caller is given a choice only between deleting an item “on hold” or putting it back in a shopping cart. Nothing in Bernard suggests doing anything else with an item a caller wants “discarded”—except deleting it, of course.

The Examiner thus essentially argues that Appellants’ invention is a good and beneficial idea, and does not even attempt to find any evidentiary basis for the purported motivation to provide specifically for the claimed features. The asserted motivation is not a finding of a teaching of the prior art that would have motivated one of ordinary skill in the art to make the suggestion combination. A proper motivation to combine must be objectively found in the prior art itself, and not derived from reading the Applicants’ disclosure.

The Examiner has not provided any evidence of record or shown that the references contain any motivation to one of ordinary skill in the art to combine the references in the manner suggested by the Examiner to provide specifically for the feature of *in response to detecting the loss of interest in the primary product, determining a package to be offered to the customer, the package comprising the primary product and at least one secondary product, the primary product and the at least one secondary product each having a corresponding retail price.*

Further, the Examiner simply has not even asserted any motivation supported by the cited references or by substantial evidence of record to modify or combine the references to provide for the specific recited features of Group Y.

Thus the Examiner has not shown substantial evidence of a motivation in the prior art of record to combine or modify the references in any manner that renders the claims of Group Y obvious. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness. The rejection of Group Y fails for at least this reason.

### **5.1.3. Any Combination of the References Fails to Teach All of the Limitations of Group Y**

Even if the Examiner had established substantial evidence of a motivation to make the proposed combination of Blinn and Bernard (which Appellants dispute above), the Examiner has failed to provide substantial evidence of a motivation to modify that combination to provide for the feature *in response to detecting the loss of interest in the primary product, determining a package to be offered to the customer, the package comprising the primary product and at least one secondary product, the primary product and the at least one secondary product each having a corresponding retail price.*

In fact, even if the references were combined in the manner suggested (let alone any other manner that the Examiner failed to suggest), the proposed combination would fail to teach *in response to detecting the loss of interest in the primary product, determining a package to be offered to the customer, the package comprising the primary product and at least one secondary product, the primary product and the at least one secondary product each having a corresponding retail price.*

Nothing in any reference of record even hints at, *in response to detecting the loss of interest in the primary product, determining a package to be offered to the customer, the package comprising the primary product and at least one secondary product, the primary product and the at least one secondary product each having a corresponding retail price.* In fact, the Examiner has failed to show that any reference of record determines a package in response to *determining the loss of interest in the primary product.* As such, any combination of the references of record fails to teach this limitation. The Examiner does not assert otherwise.

#### **5.1.4. Conclusion**

For any one of the above reasons, the Examiner has failed to establish a *prima facie* case of obviousness and the claims of Group Y are patentable.

## **5.2. Group Z: Claim 120**

Group Z includes Claim 120.

Claim 120 depends from Claim 119.

Claim 119 is discussed in Group Y. Group Z is thus allowable for at least the reasons stated with respect to Group Y.

Substantial evidence is required of all factual findings, as discussed above. Absent substantial evidence, no *prima facie* case of obviousness exists.

The rejection of Group Z is flawed because the Examiner has not made a *prima facie* case of obviousness:

- the Examiner has not established substantial evidence of the features discussed with respect to Group Y;
- the Examiner has not established substantial evidence of the features of Claim 120; and
- the Examiner has failed to provide substantial evidence of a motivation to combine or modify the references suggested.

Claim 120 contains the following limitation:

*detecting a loss of interest in the primary product comprises:*

*detecting that the customer has removed the primary product from a virtual shopping basket associated with the customer*

### **5.2.1. No substantial evidence of the limitations of Group Z**

#### **Examiner's Factual Findings**

The Examiner admits that “Blinn does not provide specific example of selecting secondary products based on an indication of interest by a customer in the secondary product.” [Sixth Office Action, page 12].

The Examiner asserts that “Bernard discloses detecting a loss of interest in a primary product by a customer, by tracking events such as when a customer removes items from a shopping card [sic]. See, for example, Col. 33, lines 4-63.” [Sixth Office Action, page 12].

### No Substantial Evidence of the Limitations

As discussed above with respect to Group Y, the Examiner has failed to establish substantial evidence of doing anything in response to detecting a loss of interest, much less determining a package to offer. Bernard does not suggest *determining a package to be offered to the customer in response to detecting the loss of interest in the primary product*. There is no suggestion of doing anything in response to having items “on hold” other than the explicitly described prompt to the caller, much less determining a package of any kind to offer a customer.

Similarly, the same portion of Bernard relied upon by the Examiner cannot support the Examiner’s assertion that it was known to determine a package offer in response to *detecting that the customer has removed the primary product from a virtual shopping basket associated with the customer*.

As discussed above with respect to Group Y, as described in the very portion of Bernard cited by the Examiner, a caller is given a choice only between deleting an item or putting it back in a shopping cart. Nothing in Bernard suggests doing anything else with an item a caller wants “discarded” or removed from a list of “on hold” items—except deleting it, of course.

Nothing in Bernard teaches or suggests “tracking” events such as a customer removing an item from a shopping cart, let alone *detecting that the customer has*

*removed the primary product from a virtual shopping basket associated with the customer*, much less doing anything in response to detecting such an event.

Effectively, the Examiner has inappropriately attempted (and failed) to demonstrate that individual elements of the limitation are present in Bernard and fails to address the limitation in its entirety.

Appellants have repeatedly read both Blinn and Bernard, and have found no hint that either reference teaches any limitation present in Claim 120.

To the extent that the Examiner is relying solely upon Blinn or Bernard as teaching any feature recited in Claim 120, the Section 103(a) rejection cannot stand. The Examiner has failed to indicate any evidence of such features, much less substantial evidence.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness, and Blinn nor Bernard cannot support any such rejection. The rejection fails for at least this reason.

#### **5.2.2. No showing of a proper motivation to combine the references**

The Examiner relies on the same motivation discussed above with respect to Group Y.

Further, the Examiner simply has not even asserted any motivation supported by the cited references or by substantial evidence of record to modify or combine the references to provide for the specific recited features of Group Z.

Thus the Examiner has not shown substantial evidence of a motivation in the prior art of record to combine or modify the references in any manner that renders the claims of Group Z obvious. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness. The rejection of Group Z fails for at least this reason.

### **5.2.3. Any Combination of the References Fails to Teach All of the Limitations of Group Z**

Even if the Examiner had established substantial evidence of a motivation to make the proposed combination of Blinn and Bernard (which Appellants dispute above), the Examiner has failed to provide substantial evidence of a motivation to modify that combination to provide for the feature *detecting that the customer has removed the primary product from a virtual shopping basket associated with the customer*.

In fact, even if the references were combined in the manner suggested (let alone any other manner that the Examiner failed to suggest), the proposed combination would fail to teach *detecting that the customer has removed the primary product from a virtual shopping basket associated with the customer*.

Nothing in any reference of record even hints at, *detecting that the customer has removed the primary product from a virtual shopping basket associated with the customer*. As such, any combination of the references of record fails to teach this limitation. The Examiner does not assert otherwise.

### **5.2.4. Conclusion**

For any one of the above reasons, the Examiner has failed to establish a *prima facie* case of obviousness and the claims of Group Z are patentable.

### **5.3. Group AA: Claim 121**

Group AA includes Claim 121.

Claim 121 depends from Claim 119.

Claim 119 is discussed in Group Y. Group AA is thus allowable for at least the reasons stated with respect to Group Y.

Substantial evidence is required of all factual findings, as discussed above. Absent substantial evidence, no *prima facie* case of obviousness exists.

The rejection of Group AA is flawed because the Examiner has not made a *prima facie* case of obviousness:

- the Examiner has not established substantial evidence of the features discussed with respect to Group Y;
- the Examiner has not established substantial evidence of the features of Claim 121; and
- the Examiner has failed to provide substantial evidence of a motivation to combine or modify the references suggested.

Claim 121 contains the following limitation:

*wherein detecting a loss of interest in the primary product comprises:  
determining that the customer has expressed interest in another product  
without having placed the primary product in a virtual shopping basket*

#### **5.3.1. No substantial evidence of the limitations of Group AA**

##### **Examiner's Factual Findings**

The Examiner admits that “Blinn does not provide specific example of selecting secondary products based on an indication of interest by a customer in the secondary product.” [Sixth Office Action, page 12].



The Examiner asserts that “Bernard discloses detecting a loss of interest in a primary product by a customer, by tracking events such as when a customer removes items from a shopping card [sic]. See, for example, Col. 33, lines 4-63.” [Sixth Office Action, page 12].

### No Substantial Evidence of the Limitations

As discussed above with respect to Group Y, the Examiner has failed to establish substantial evidence of doing anything in response to detecting a loss of interest, much less determining a package to offer. Bernard does not suggest *determining a package to be offered to the customer in response to detecting the loss of interest in the primary product*. There is no suggestion of doing anything in response to having items “on hold” other than the explicitly described prompt to the caller, much less determining a package of any kind to offer a customer.

Similarly, the same portion of Bernard relied upon by the Examiner cannot support the Examiner’s assertion that it was known to determine a package offer in response to *determining that the customer has expressed interest in another product without having placed the primary product in a virtual shopping basket*.

As discussed above with respect to Group Y, as described in the very portion of Bernard cited by the Examiner, a caller is given a choice only between deleting an item or putting it back in a shopping cart. Nothing in Bernard suggests doing anything else with an item a caller wants “discarded” or removed from a list of “on hold” items—except deleting it, of course.

Nothing in Bernard teaches or suggests “tracking” events such as a customer removing an item from a shopping cart, let alone *determining that the customer has expressed interest in another product without having placed the primary product in a virtual shopping basket*, much less doing anything in response to detecting such an event.

Effectively, the Examiner has inappropriately attempted (and failed) to demonstrate that individual elements of the limitation are present in Bernard and fails to address the limitation in its entirety.

Appellants have repeatedly read both Blinn and Bernard, and have found no hint that either reference teaches any limitation present in Claim **121**.

To the extent that the Examiner is relying solely upon Blinn or Bernard as teaching any feature recited in Claim **121**, the Section 103(a) rejection cannot stand. The Examiner has failed to indicate any evidence of such features, much less substantial evidence.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness, and Blinn nor Bernard cannot support any such rejection. The rejection fails for at least this reason.

**5.3.2. No showing of a proper motivation to combine the references**

The Examiner relies on the same motivation discussed above with respect to Group Y.

Further, the Examiner simply has not even asserted any motivation supported by the cited references or by substantial evidence of record to modify or combine the references to provide for the specific recited features of Group AA.

Thus the Examiner has not shown substantial evidence of a motivation in the prior art of record to combine or modify the references in any manner that renders the claims of Group AA obvious. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness. The rejection of Group AA fails for at least this reason.

### **5.3.3. Any Combination of the References Fails to Teach All of the Limitations of Group AA**

Even if the Examiner had established substantial evidence of a motivation to make the proposed combination of Blinn and Bernard (which Appellants dispute above), the Examiner has failed to provide substantial evidence of a motivation to modify that combination to provide for the feature *determining that the customer has expressed interest in another product without having placed the primary product in a virtual shopping basket*.

In fact, even if the references were combined in the manner suggested (let alone any other manner that the Examiner failed to suggest), the proposed combination would fail to teach *determining that the customer has expressed interest in another product without having placed the primary product in a virtual shopping basket*.

Nothing in any reference of record even hints at, *determining that the customer has expressed interest in another product without having placed the primary product in a virtual shopping basket*. As such, any combination of the references of record fails to teach this limitation. The Examiner does not assert otherwise.

### **5.3.4. Conclusion**

For any one of the above reasons, the Examiner has failed to establish a *prima facie* case of obviousness and the claims of Group AA are patentable.

#### **5.4. Group BB: Claim 122**

Group BB includes Claim 122.

Claim 122 depends from Claim 119.

Claim 119 is discussed in Group Y. Group BB is thus allowable for at least the reasons stated with respect to Group Y.

Substantial evidence is required of all factual findings, as discussed above. Absent substantial evidence, no *prima facie* case of obviousness exists.

The rejection of Group BB is flawed because the Examiner has not made a *prima facie* case of obviousness:

- the Examiner has not established substantial evidence of the features discussed with respect to Group Y;
- the Examiner has not established substantial evidence of the features of Claim 121; and
- the Examiner has failed to provide substantial evidence of a motivation to combine or modify the references suggested.

Claim 122 contains the following limitation:

*wherein detecting a loss of interest in the primary product comprises:  
determining that the primary product has been in a virtual shopping basket associated with the customer for a predetermined amount of time without having been purchased*

##### **5.4.1. No substantial evidence of the limitations of Group BB**

##### **Examiner's Factual Findings**

The Examiner admits that “Blinn does not provide specific example of selecting secondary products based on an indication of interest by a customer in the secondary product.” [Sixth Office Action, page 12].

The Examiner asserts that “Bernard discloses detecting a loss of interest in a primary product by a customer, by tracking events such as when a customer removes items from a shopping card [sic]. See, for example, Col. 33, lines 4-63.” [Sixth Office Action, page 12].

### No Substantial Evidence of the Limitations

As discussed above with respect to Group Y, the Examiner has failed to establish substantial evidence of doing anything in response to detecting a loss of interest, much less determining a package to offer. Bernard does not suggest *determining a package to be offered to the customer in response to detecting the loss of interest in the primary product*. There is no suggestion of doing anything in response to having items “on hold” other than the explicitly described prompt to the caller, much less determining a package of any kind to offer a customer.

Similarly, the same portion of Bernard relied upon by the Examiner cannot support the Examiner’s assertion that it was known to determine a package offer in response to *determining that the primary product has been in a virtual shopping basket associated with the customer for a predetermined amount of time without having been purchased*.

As discussed above with respect to Group Y, as described in the very portion of Bernard cited by the Examiner, a caller is given a choice only between deleting an item or putting it back in a shopping cart. This would suggest that the “on hold” item is not in the shopping cart. Accordingly, Bernard would not suggest *determining that the primary product has been in a virtual shopping basket associated with the customer for a predetermined amount of time without having*

*been purchased*. Nothing in Bernard suggests doing anything else with an item a caller wants “discarded” or removed from a list of “on hold” items—except deleting it, of course.

Nothing in Bernard teaches or suggests “tracking” events such as a customer removing an item from a shopping cart, let alone *determining that the primary product has been in a virtual shopping basket associated with the customer for a predetermined amount of time without having been purchased*, much less doing anything in response to detecting such an event.

Effectively, the Examiner has inappropriately attempted (and failed) to demonstrate that individual elements of the limitation are present in Bernard and fails to address the limitation in its entirety.

Appellants have repeatedly read both Blinn and Bernard, and have found no hint that either reference teaches any limitation present in Claim 122.

To the extent that the Examiner is relying solely upon Blinn or Bernard as teaching any feature recited in Claim 122, the Section 103(a) rejection cannot stand. The Examiner has failed to indicate any evidence of such features, much less substantial evidence.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness, and Blinn nor Bernard cannot support any such rejection. The rejection fails for at least this reason.

#### **5.4.2. No showing of a proper motivation to combine the references**

The Examiner relies on the same motivation discussed above with respect to Group Y.

Further, the Examiner simply has not even asserted any motivation supported by the cited references or by substantial evidence of record to modify or combine the references to provide for the specific recited features of Group BB.

Thus the Examiner has not shown substantial evidence of a motivation in the prior art of record to combine or modify the references in any manner that renders the claims of Group BB obvious. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness. The rejection of Group BB fails for at least this reason.

#### **5.4.3. Any Combination of the References Fails to Teach All of the Limitations of Group BB**

Even if the Examiner had established substantial evidence of a motivation to make the proposed combination of Blinn and Bernard (which Appellants dispute above), the Examiner has failed to provide substantial evidence of a motivation to modify that combination to provide for the feature *determining that the primary product has been in a virtual shopping basket associated with the customer for a predetermined amount of time without having been purchased*.

In fact, even if the references were combined in the manner suggested (let alone any other manner that the Examiner failed to suggest), the proposed combination would fail to teach *determining that the primary product has been in a virtual shopping basket associated with the customer for a predetermined amount of time without having been purchased*.

Nothing in any reference of record even hints at, *determining that the primary product has been in a virtual shopping basket associated with the customer for a predetermined amount of time without having been purchased*. As such, any combination of the references of record fails to teach this limitation. The Examiner does not assert otherwise.

#### **5.4.4. Conclusion**

For any one of the above reasons, the Examiner has failed to establish a *prima facie* case of obviousness and the claims of Group BB are patentable.



## CONCLUSION

Thus, the Examiner's rejection of the pending claims is improper at least because the Examiner has not provided a proper legal basis for rejecting any claim. Therefore, Appellants respectfully request that the Examiner's rejections be reversed.

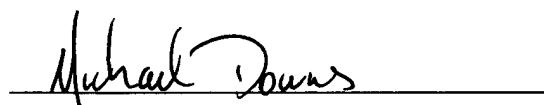
If any issues remain, or if there are any further suggestions for expediting allowance of the present application, please contact Michael Downs using the information provided below.

Appellants hereby request any extension of time that may be required to make this Appeal Brief timely. Please charge any fees that may be required for this paper, or credit any overpayment, to Deposit Account No. 50-0271.

Respectfully submitted,

August 1, 2005

Date

A handwritten signature in black ink, reading "Michael Downs", is written over a horizontal line.

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## **APPENDIX A—CLAIMS INVOLVED IN THE APPEAL**

**Claims 3, 6, 7, 12, 13, 18, 19, 20, 23, 24, 29-35, 39, 40, 42, 44-46, 50, 53, 55, 56, 61, 66-68, 70-72, 75, 78, 79, 82, 85, 86, 88, 89, 93-96, 100-107, 113, 114, 116, 117, and 119-126** are being appealed.

**Appealed Claims 13, 19, 30, 35, 119, and 123-126** are independent.

3. The method of claim 1, wherein detecting that the primary product is of interest to the customer comprises detecting that information relating to the primary product is displayed on a web-page viewed by the customer for a pre-determined amount of time.

6. The method of claim 1, wherein detecting that the primary product is of interest to the customer comprises:

detecting at least one keyword input by the customer into an input field on a web-page; and

determining that the at least one keyword relates to the primary product.

7. The method of claim 1, wherein detecting that the primary product is of interest to the customer comprises receiving a customer request for a customer requested package associated with the primary product.

12. The method of claim 1, wherein determining the package to be offered to the customer comprises accessing a database to select the at least one secondary product from a plurality of available secondary products based on at least one of the profit margin of the primary product and the profit margin of the at least one secondary product.

13. A computer-readable medium having stored thereon computer-executable instructions for performing a method comprising steps of:

detecting that a primary product is of interest to a customer, the primary product having an associated primary product identifier;

in response to detecting that the primary product is of interest to the customer, determining a package to be offered to the customer, the package

comprising the primary product and at least one secondary product, the primary product and the at least one secondary product each having a corresponding retail price,

wherein at least one of the at least one secondary product is a product not currently selected for purchase by the customer, and further

wherein at least one of the at least one secondary product is selected for inclusion in the package based on an indication of interest, by the customer, in the at least one secondary product;

in response to determining the package, determining a package price which is less than a sum of the corresponding retail prices of the primary product and the at least one secondary product; and

presenting a package offer for sale of the package at the package price to the customer,

wherein determining the package to be offered to the customer comprises accessing a database to select the at least one secondary product from a plurality of available secondary products based on at least one of the profit margin of the primary product and the profit margin of the at least one secondary product.

18. The method of claim 1, wherein determining the package price comprises:

determining a discounted price for each of the at least one secondary product; and

summing the retail price of the primary product and the discounted price for the at least one secondary product to calculate the package price.

19. A computer-readable medium having stored thereon computer-executable instructions for performing a method comprising steps of:

detecting that a primary product is of interest to a customer, the primary product having an associated primary product identifier;

in response to detecting that the primary product is of interest to the customer, determining a package to be offered to the customer, the package comprising the primary product and at least one secondary product, the primary product and the at least one secondary product each having a corresponding retail price,

wherein at least one of the at least one secondary product is a product not currently selected for purchase by the customer, and further

wherein at least one of the at least one secondary product is selected for inclusion in the package based on an indication of interest, by the customer, in the at least one secondary product;

in response to determining the package, determining a package price which is less than a sum of the corresponding retail prices of the primary product and the at least one secondary product;

presenting a package offer for sale of the package at the package price to the customer,

wherein determining the package price comprises:

determining a discounted price for each of the at least one secondary product; and

summing the retail price of the primary product and the discounted price for the at least one secondary product to calculate the package price.

20. The method of claim 18, wherein the discounted price for each of the at least one secondary product is based on a profit margin of the primary product.

23. The method of claim 21, wherein the discounted price for each of the primary product and the at least one secondary products is based on a profit margin of the primary product and a profit margin of the at least one secondary product.

24. The method of claim 1, further comprising:  
in response to presenting the package offer to the customer, receiving a customer response indicating a rejection of the package offer; and  
in response to the customer response, determining another package to be offered to the customer.

29. The method of claim 1, wherein the package comprises the primary product and a plurality of secondary products; and  
wherein the package offer comprises an offer for sale of a pre-determined number of the secondary products, selected by the customer, at the package price.

30. A computer-readable medium having stored thereon computer-executable instructions for performing a method comprising steps of:  
detecting that a primary product is of interest to a customer, the primary product having an associated primary product identifier;  
in response to detecting that the primary product is of interest to the customer, determining a package to be offered to the customer, the package comprising the primary product and at least one secondary product, the primary product and the at least one secondary product each having a corresponding retail price,  
wherein at least one of the at least one secondary product is a product not currently selected for purchase by the customer, and further

wherein at least one of the at least one secondary product is selected for inclusion in the package based on an indication of interest, by the customer, in the at least one secondary product;

in response to determining the package, determining a package price which is less than a sum of the corresponding retail prices of the primary product and the at least one secondary product; and

presenting a package offer for sale of the package at the package price to the customer,

wherein the package comprises the primary product and a plurality of secondary products; and

wherein the package offer comprises an offer for sale of a pre-determined number of the secondary products, selected by the customer, at the package price.

31. The method of claim 1, wherein the package comprises the primary product and a plurality of secondary products; and

wherein the package offer comprises an offer for sale of a customer-selected number of the secondary products, selected by the customer, at the package price.

32. The method of claim 29, wherein the package price varies based on the customer-selected number of secondary products.

33. A computer-readable medium having stored thereon computer-executable instructions for performing the method of claim 32.

34. The method of claim 1, wherein the package comprises the primary product and a plurality of lists of secondary products; and

wherein the package offer comprises an offer for sale of a pre-determined number of the secondary products selected by the customer from each of the plurality of lists, at the package price.

35. A computer-readable medium having stored thereon computer-executable instructions for performing a method comprising steps of:

detecting that a primary product is of interest to a customer, the primary product having an associated primary product identifier;

in response to detecting that the primary product is of interest to the customer, determining a package to be offered to the customer, the package comprising the primary product and at least one secondary product, the primary product and the at least one secondary product each having a corresponding retail price,

wherein at least one of the at least one secondary product is a product not currently selected for purchase by the customer, and further

wherein at least one of the at least one secondary product is selected for inclusion in the package based on an indication of interest, by the customer, in the at least one secondary product;

in response to determining the package, determining a package price which is less than a sum of the corresponding retail prices of the primary product and the at least one secondary product; and

presenting a package offer for sale of the package at the package price to the customer,

wherein the package comprises the primary product and a plurality of lists of secondary products; and



wherein the package offer comprises an offer for sale of a pre-determined number of the secondary products selected by the customer from each of the plurality of lists, at the package price.

39. The method of claim 38, wherein the printed version comprises a code identifying the package offer and product identifiers for the primary product and the at least one secondary product included in the package.

40. The method of claim 37, wherein the input device comprises a bar code reader.

42. The method of claim 41, wherein the customer response further indicates a code identifying the package offer and product identifiers for the primary product and the at least one secondary product included in the package.

44. The method of claim 1, wherein the primary product is sold by a first retailer;

wherein the method further comprises storing in a database information relating to a plurality of available secondary products sold by a second retailer; and

wherein determining the package to be offered to the customer comprises accessing the database to select the at least one secondary product from the plurality of available secondary products, the at least one secondary product having a predetermined relationship with the primary product.

45. The method of claim 44, further comprising receiving a customer response indicating an account identifier and an acceptance of the package offer;

in response to the customer response, charging a financial account identified by the account identifier for the amount of the package price; and

in response to charging the financial account, authorizing the first retailer to deliver the primary product to the customer and authorizing the second retailer to deliver the at least one secondary product to the customer.

46. The method of claim 45, further comprising distributing an appropriate portion of the charged package price to each of the first retailer and the second retailer.

50. The method of claim 47, wherein indicating the interest in the primary product comprises viewing a web-page displaying information relating to the primary product for a pre-determined amount of time.

53. The method of claim 47, wherein indicating the interest in the primary product comprises inputting at least one keyword into an input field on a web-page, the at least one keyword relating to the primary product.

55. The method of claim 54, wherein obtaining the primary product and the at least one secondary product from the retailer comprises visiting a retail establishment of the retailer to pick up the primary product and the at least one secondary product.

56. The method of claim 55, further comprising receiving a code from the retailer; and

upon visiting the retail establishment, presenting the code to the retailer,

whereby the retailer may use the code to verify that the financial account has been charged in the amount of the package price.

61. The method of claim 59, wherein the central server communicates with a database to determine the package offer, the at least one secondary product being selected from a record of available secondary products based on a profit margin of the primary product.

66. The method of claim 64, wherein the input device comprises a bar code reader.

67. The method of claim 58, wherein the point of sale terminal communicates with a central server to determine the package price; and wherein the point of sale terminal communicates with a financial institution to charge the package price to the financial account.

68. The method of claim 47, wherein indicating the interest in the primary product comprises requesting a package associated with the primary product.

70. The method of claim 69, further comprising obtaining the primary product and the at least one secondary product from the plurality of different retailers by visiting each of the plurality of different retailers to pick up the primary product and the at least one secondary products.

71. The method of claim 70, further comprising receiving a code in response to providing the customer response; and

upon visiting the plurality of different retailers, presenting the code to each of the plurality of different retailers,

whereby each of the plurality of different retailers may use the code to verify that the financial account has been charged in the amount of the package price.

72. The method of claim 69, further comprising obtaining the primary product and the at least one secondary product from the plurality of different retailers by receiving a plurality of shipments containing the primary product and the at least one secondary product.

75. The system of claim 74, wherein the data received from the customer device indicates that information relating to the primary product has been displayed on a web-page viewed by the customer for a pre-determined amount of time.

78. The system of claim 74, wherein the data received from the customer device comprises at least one keyword input by the customer into an input field on a web-page, the at least one keyword relating to the primary product.

79. The system of claim 74, wherein the data received from the customer device comprises a customer request for a customer requested package associated with the primary product.

82. The system of claim 74, wherein accessing the database to determine the package comprises selecting the at least one secondary product from a plurality of available secondary products stored in the database based on at least one of the

profit margin of the primary product and the profit margin of the at least one secondary product.

85. The system of claim 74, wherein determining the package price comprises:

determining a discounted price for each of the at least one secondary product; and

summing the retail price of the primary product and the discounted price for the at least one secondary product to calculate the package price.

86. The system of claim 85, wherein the discounted price for each of the at least one secondary product is based on a profit margin of the primary product.

88. The system of claim 87, wherein the discounted price for each of the primary product and the at least one secondary products is based on a profit margin of the primary product and a profit margin of the at least one secondary product.

89. The system of claim 74, wherein the processor is further operable to: receive a customer response, via the communications port, indicating a rejection of the package offer; and

in response to the customer response, access the database to determine another package to be offered to the customer.

93. The system of claim 74, wherein the package comprises the primary product and a plurality of secondary products; and

wherein the package offer comprises an offer for sale of a pre-determined number of the secondary products, selected by the customer, at the package price.

94. The system of claim 74, wherein the package comprises the primary product and a plurality of secondary products; and  
wherein the package offer comprises an offer for sale of a customer-selected number of the secondary products, selected by the customer, at the package price.

95. The system of claim 94, wherein the package price varies based on the customer-selected number of secondary products.

96. The system of claim 74, wherein the package comprises the primary product and a plurality of lists of secondary products; and  
wherein the package offer comprises an offer for sale of a pre-determined number of the secondary products selected by the customer from each of the plurality of lists, at the package price.

100. The system of claim 99, wherein the printed version comprises a code identifying the package offer and product identifiers for the primary product and the at least one secondary product included in the package.

101. The system of claim 98, wherein the input device comprises a bar code reader.

102. The system of claim 74, wherein the processor is further operable to:  
receive from a point of sale terminal, via the communications port, a customer response indicating an account identifier and an acceptance of the package offer; and

in response to the customer response, send an authorization to the point of sale terminal, via the communications port, authorizing a charge to a financial account identified by the account identifier for the amount of the package price.

103. The system of claim 102, wherein the customer response further indicates a code identifying the package offer and product identifiers for the primary product and the at least one secondary product included in the package.

104. The system of claim 102, wherein the processor is further operable to store transaction data relating to sale of the package in the database.

105. The system of claim 74, wherein the primary product is sold by a first retailer;

wherein the database stores information relating to a plurality of available secondary products sold by a second retailer; and

wherein accessing the database to determine the package comprises accessing the database to select the at least one secondary product from the plurality of available secondary products, the at least one secondary product having a predetermined relationship with the primary product.

106. The system of claim 105, wherein the processor is further operable to: receive from a customer device, via the communications port, a customer response indicating an account identifier and an acceptance of the package offer; in response to the customer response, authorize a charge to a financial account identified by the account identifier for the amount of the package price; and

in response to authorizing the charge to the financial account, authorize the first retailer to deliver the primary product to the customer and authorize the second retailer to deliver the at least one secondary product to the customer.

107. The system of claim 106, wherein the processor is further operable to facilitate distribution of an appropriate portion of the charged package price to each of the first retailer and the second retailer.

113. The system of claim 108, wherein the input signal indicating the interest in the primary product comprises at least one keyword input into an input field on a web-page, the at least one keyword relating to the primary product.

114. The system of claim 109, wherein the processor is further operable to receive a code via the communications port in response to sending the customer response,

whereby the code may be presented to a retailer for verification that the financial account has been charged in the amount of the package price.

116. The system of claim 108, further comprising a printer operable to print a printed version of the package offer, the printed version comprising a code identifying the package offer and product identifiers for the primary product and the at least one secondary product included in the package.

117. The system of claim 108, wherein the input signal indicating an interest in the primary product comprises a request for a package associated with the primary product.



119. A method for determination and presentation of a package offer comprising the steps of:

detecting that a primary product is of interest to a customer, the primary product having an associated primary product identifier;

detecting a loss of interest in the primary product by the customer;

in response to detecting the loss of interest in the primary product, determining a package to be offered to the customer, the package comprising the primary product and at least one secondary product, the primary product and the at least one secondary product each having a corresponding retail price;

in response to determining the package, determining a package price which is less than a sum of the corresponding retail prices of the primary product and the at least one secondary product; and

presenting a package offer for sale of the package at the package price to the customer.

120. The method of claim 119, wherein detecting a loss of interest in the primary product comprises:

detecting that the customer has removed the primary product from a virtual shopping basket associated with the customer.

121. The method of claim 119, wherein detecting a loss of interest in the primary product comprises:

determining that the customer has expressed interest in another product without having placed the primary product in a virtual shopping basket.

122. (Previously Presen The method of claim 119, wherein detecting a loss of interest in the primary product comprises:

determining that the primary product has been in a virtual shopping basket associated with the customer for a predetermined amount of time without having been purchased.

123. (Currently Amended) An apparatus, comprising:  
a processor, and  
a storage device that stores a program for directing the processor;  
the processor being operative with the program to:  
perform the a method comprising steps of: claim 119  
detecting that a primary product is of interest to a customer, the primary product having an associated primary product identifier;  
detecting a loss of interest in the primary product by the customer;  
in response to detecting the loss of interest in the primary product,  
determining a package to be offered to the customer, the package comprising the primary product and at least one secondary product, the primary product and the at least one secondary product each having a corresponding retail price;  
in response to determining the package, determining a package price which is less than a sum of the corresponding retail prices of the primary product and the at least one secondary product; and  
presenting a package offer for sale of the package at the package price to the customer.

124. A computer readable medium encoded with instructions for directing a processor to:  
perform a method comprising steps of:  
detecting that a primary product is of interest to a customer, the primary product having an associated primary product identifier;

detecting a loss of interest in the primary product by the customer;  
in response to detecting the loss of interest in the primary product,  
determining a package to be offered to the customer, the package comprising the  
primary product and at least one secondary product, the primary product and the at  
least one secondary product each having a corresponding retail price;  
in response to determining the package, determining a package price which  
is less than a sum of the corresponding retail prices of the primary product and the  
at least one secondary product; and  
presenting a package offer for sale of the package at the package price to the  
customer.

125. A method for assembly, presentation and redemption of a package  
offer comprising the steps of:

indicating an interest in a primary product;  
indicating a loss of interest in the primary product;  
in response to indicating the loss of interest in the primary product, being  
presented with a package offer to purchase a package at a package price, the  
package comprising the primary product and at least one secondary product; and  
providing a customer response comprising an account identifier and an  
indication of an acceptance of the package offer, the acceptance of the package  
offer authorizing a charge to a financial account identified by the account identifier  
for the amount of the package offer price.

126. A system for assembly, presentation and redemption of a package  
offer comprising:

a processor;

a communications port in communication with the processor operable to send and receive data;

a database in communication with the processor operable to store information relating to products stored by corresponding product identifiers; and wherein the processor is operable to:

interpret data received via the communications port from a customer device as indicating an expression of interest by a customer in a primary product;

interpret data received via the communication port from a customer device as indicating a loss of interest by the customer in the primary product;

in response to the data indicating the loss of interest, access the database to determine a package to be offered to the customer, the package comprising the primary product and at least one secondary product, the primary product and the at least one secondary product each having a corresponding retail price;

determine a package price which is less than the sum of the corresponding retail prices of the primary product and the at least one secondary product; and

present a package offer for the sale of the package at the package price to the customer.

## **APPENDIX B—EVIDENCE**

<NONE>

**APPENDIX C—RELATED PROCEEDINGS**

<NONE>